Paid $ 15 cts

19-433

Justice Davis

Justice Swayne to write.

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~396~~ 181.

ALBERT KLEIN, PLAINTIFF IN ERROR,

vs.

NATHAN C. RUSSELL.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF NEW YORK.

FILED JUNE 15, 1872.

Dec. Dec. 1873

Oct. Term 1873

SUPREME COURT OF THE UNITED STATES.

No. 396.

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1 United States circuit court, northern district of New York.

NATHAN C. RUSSELL
vs.
ALBERT KLEIN. } Pl'ff's costs.

Costs.

Attorney's trial-fee	$20 00	
		$20 00

DISBURSEMENTS.

Witness fees paid, viz:		
Edward Ward, David Brower, & James Hewitson, 2 days' attendance each, and 51 miles travel each, one way, at the Albany Oct. term 1870	24 30	
James Hewitson, James H. Brownell, David Brower, C. A. King, W. W. Whitaker, Theodore Welch, Daniel Hullett, John Fulton, Archibald Gulick, Charles H. Porter, Edward Ward, William Combs, George W. Gillett, George Purcell, & Isaac V. Place, 5 days' attendance each, and 51 miles travel each, one way, except Charles H. Porter,		
2 who travelled 95 miles one way	$201 80	
3 affidavits	30	
Postages	51	
Printing points on motion for new trial	18 00	
		$214 91

CLERK'S FEES.

Docketing & filing warrant and copy rule to plead	$2 00	
Copy def't's appearance	50	
4 subpoenas and 18 copies	5 50	
Filing note of issue and putting case on calendar 3 terms	1 65	
Oath to ten witnesses on trial	1 00	
Filing affidavits and orders	40	
Making docket & indexes & taxing costs	3 00	
Copy order & certificate on case made	1 00	
Rule for judgment	1 00	
Issuing execution	1 00	
		$17 05
Total amount of pl'ff's costs and disbursements		$281 96

Taxed at $281.96.
October 25, 1871.

CHARLES MASON, *Clerk.*

3 United States circuit court, northern district of New York.

NATHAN C. RUSSELL
vs.
ALBERT KLEIN. }

UNITED STATES OF AMERICA,
Northern District of New York, ss:

NATHAN C. RUSSELL, of Gloversville, in said northern district of

New York, being duly sworn, says that he is the plaintiff in this cause, and Edward Ward, David Brower, and James Hewitson were severally subpœnaeed and attended as witnesses on the part of the plaintiff in this cause, at the Albany October term, 1870, at which term this cause was noticed for trial on both sides, and they were severally and necessarily in attendance as such witnesses at said term two days each; that they severally reside in Gloversville aforesaid, and travelled fifty-one miles each one way, from his place of residence to attend as aforesaid; that said witnesses, together with the others named in the fore-
4 going bill of costs, were severally subpœnaed and attended as witnesses on the part of the plaintiff in this cause; and that they were severally and necessarily in attendence five days each on the trial of this cause, at the March term, in Utica, 1871; that all of said witnesses, except Charles H. Porter, reside in Gloversville aforesaid, and travelled fifty-seven miles each, one way, from his place of residence, to attend the trial of this action; and that Charles H. Porter travelled ninety-five miles from the city of Albany, his residence, to be present at the trial of this action.

N. C. RUSSELL.

Subscribed and sworn to before me this 20th day of October, 1871.
[SEAL.] W. D. WEST,
Notary Public.

United States circuit court, northern district of New York.

NATHAN C. RUSSELL
vs.
ALBERT KLEIN.

UNITED STATES OF AMERICA,
Northern District of New York, ss:

5 BORDEN D. SMITH, of Johnstown, in said northern district of New York, being duly sworn, says he is, & since the commencement of this action has been, clerk for the attorney for the plaintiff herein, & is acquainted with the disbursements made in this cause; that the disbursements in the foregoing bill of costs, except witness-fees, have been actually made and incurred herein on the part of said Nathan C. Russell, except those hereafter to be incurred; and those deponent believes to be correctly stated in said bill.

That the cause was necessarily on the calendar the terms in said bill named.

BORDEN D. SMITH.

Subscribed & sworn to before me this 25th day of October, 1871.
[SEAL.] I. J. GRAY,
Notary Public, Oneida County.

6 (Endorsed:) United States circuit court, northern district of New York. Nathan C. Russell vs. Albert Klein. Items of pl'ff's costs & disbursements & copy notice of adjustment.

SIR: The within is a copy of the items of pl'ff's costs & disbursements in this action, and the same will be adjusted by the clerk of the

U. S. circuit court for the northern district of New York, at his office, in Utica, N. Y., on the 25th day of October, 1871, at 10 o'clock a. m.

Yours, &c.

HORACE E. SMITH,
Pl'ff's Att'y.

To HIRAM S. PARKHURST,
Def't's Att'y.

Due and personal service of a copy of the within bill of costs & notice of adjustment, of which the above is a copy, is admitted this 17th day of October, 1871.

HIRAM S. PARKHURST,
Def't's Att'y.

Filed October 25, 1871.

7 United States circuit court, northern district of New York, ss:

Pleas before the judges of the circuit court of the United States of America, in and for the northern district of New York, in the second circuit, at the March term of said court, A. D. 1870. Present, Hon. Nathan K. Hall, judge; Augustus A. Boyce, clerk.

NORTHERN DISTRICT OF NEW YORK, *ss:*

Be it remembered that heretofore, to wit, at the March term of said circuit court, A. D. 1870, to wit, and of the 20th day of June, A. D. 1870, came Nathan C. Russell by H. E. Smith, his attorney, and brought into said court his certain declaration against Albert Klein, which said declaration was and is in the words and figures following, to wit:

8 United States circuit court for the northern district of New York, in the second circuit.

NATHANIEL C. RUSSELL
vs.
ALBERT KLEIN.

Of the 20th day of June, 1870, as yet of the March adjourned term, in the year 1870.

NORTHERN DISTRICT OF NEW YORK, *ss:*

Nathaniel C. Russell, of Johnstown, in the county of Fulton, and State of New York, a citizen of said State, and of the United States, plaintiff in this suit, by Horace E. Smith, his attorney, comes into this court according to the practice thereof, and complains of Albert Klein, of Johnstown aforesaid, within said northern district of New York, a citizen of *of* said State, and of the United States, defendant in this suit, of a plea of trespass on the case.

For that whereas the plaintiff was the original and first inventor and discoverer of a new and useful improvement in the preparation and treatment of leather, in the letters-patent hereinafter mentioned and fully described, the same being a new and useful improvement
9 in the treatment of leather which was not known or used before his said invention and discovery, and which was not, at the time of his application for a patent, as hereinafter mentioned, in public use or on sale with his consent or allowance, nor patented, printed, or published in any foreign country, and the plaintiff being so as aforesaid the inventor and discoverer thereof, and being also a citizen of the

United States, on the seventeenth day of August, one thousand eight hundred and *and* sixty-nine, upon due application therefor, did obtain letters-patent therefor under the seal of the Patent-Office of the United States, signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents of the United States, bearing date the day and year aforesaid. That thereafterwards, on the first day of February, one thousand eight hundred and seventy, said letters-patent having been duly surrendered by the plaintiff to the Commissioner of Patents, and canceled, and a new patent for the improvement aforesaid ordered to be issued upon an amended specification, in accordance with
10 the statute of the United States, the plaintiff, upon a full compliance with all the provisions of law in such cases made and provided, did obtain certain other letters-patent of the United States for said new and useful improvement in the treatment of leather in due form of law, under the seal of the Patent-Office of the United States, signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid, whereby there was granted and secured to him, his heirs, executors, administrators, and assigns, for the term of fourteen years from and after the seventeenth day of August, one thousand eight hundred and sixty-nine, the full and exclusive right and liberty of making, using, and vending to others to be used the said invention and improvement, as by the said letters-patent, in court to be produced, will fully appear.

And the plaintiff further says that, from the time of the granting to him of said letters-patent last aforesaid, hitherto he has made,
11 used, and vended to others to be used the *the* said invention and improvement to his great advantage and profit, and that the said exclusive right has been and is of great value to him, to wit, of the value of fifty thousand dollars.

Yet the said defendant, well knowing the premises, but contriving and wrongfully intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending of the said invention, and without the consent and allowance, and against the will of the plaintiff, has on divers days and times since the first day of February, one thousand eight hundred and seventy, and before the commencement of this suit, at Johnstown, aforesaid, and divers other places in said northern district of New York, made and used the said invention and improvement, so patented as aforesaid, and caused the same to be used by others, in violation and infringement
12 of the exclusive right so secured to the plaintiff by said letters, patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided, whereby the plaintiff has been greatly injured and deprived of great profits and advantages which he might and otherwise would have derived from said invention, and has sustained actual damage to the amount of one thousand dollars, and by force of the statute aforesaid an action has accrued to him to recover the said actual damages, and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to order and adjudge, together with costs, yet the said defendant, though requested, has never paid the same or any part thereof, to the plaintiff, but has refused and yet refuses so to do, to the dam ge of the plaintiff of two thousand dollars; and therefore he brings his suit, &c.

HORACE E. SMITH,
Plaintiff's Attorney, Johnstown, N. Y.

13 (Endorsed:) United States circuit court, second circuit. Nathaniel C. Russell vs. Albert Klein. Narr. H. E. Smith, plaintiff's attorney, Johnstown, N. Y. Filed June 20, 1870.

And afterwards and on the 8th day of July, A. D. 1870, the said defendant appeared in said action by H. S. Parkhurst, his attorney, and filed his plea & notice to the said declaration of the said plaintiff, which said plea & notice was and is in the words and figures following, to wit:

14 United States circuit court for the northern district of New York in the second circuit.

NATHAN C. RUSSELL
against
ALBERT KLEIN.

NORTHERN DISTRICT OF NEW YORK, *ss*:

And the said Albert Klein, defendant in this suit, by H. S. Parkhurst, his attorney, comes and defends the wrong and injury when, &c. and says that he is not guilty of said supposed grievances above, laid to his charge, in manner and form as the said plaintiff hath thereof complained against him, &c.; and of this said defendant puts himself upon the country. And the said plaintiff doth the like, &c.

And it is suggested to the court now here that the defendant gives the following notices, in writing, of special matter to the plaintiff, thirty days before trial, under section 15 of the act of Congress passed July 4th, 1836, entitled "An act to promote the progress of the
15 useful arts, and to repeal all acts and parts of acts heretofore made for that purpose."

FIRST NOTICE OF SPECIAL MATTER.—Take notice that the above-named defendant will prove, upon the trial of this cause in bar of the said plaintiff's action, that the said Nathan C. Russell was not the first or original inventor of a new and useful improvement in the preparation and treatment of leather, described in letters-patent issued to the said plaintiff, and dated August 17th, 1869.

And which said letters-patent were surrendered and cancelled, and a new patent for the improvement aforesaid was issued upon an amended specification, and which said last letters-patent bear date February 1, 1870. And which said improvement consisted of making bark-tanned sheep'kin leather soft and pliable, by reason of using a compound of which fat liquor is the base, more fully described in said letters-patent, by reason of which treatment the said leather was rendered more
16 suitable for making into gloves, and a variety of other uses for which said leather was not fit before said treatment.

And the said defendant will further prove upon such trial, as aforesaid, that the said principle was known to and had been previously invented by Isaac V. Place and Philander Deeacock. Said Isaac V. Place resides at Gloversville, in the State of New York. Said Philander Deeacock is now deceased; and that the same was known to and combined by said Isaac V. Place and Philander Deeacock so early as the year 1845.

And the said defendant will further prove upon said trial, as aforesaid, that what is claimed in said declaration and in said letters-patent therein mentioned, and the specifications and drawings thereto attached, as the invention of said plaintiff named in said declaration, was sub-

stantially and in principle known to Philander Deeacock, now deceased, and formerly of the town of Johnstown and State of New York,
17 Isaac V. Place, John N. Place, James Kent, David Brower, Purdy Van Wort, and Samuel Dodge, s'r, of Gloversville, in the State of New York.

And the said defendant will further prove upon said trial, as aforesaid, that the thing patented in and by the letters-patent was not first invented by or known to said Nathan C. Russell, but the same was publicly known and used prior to the time when it is alleged in this action the same was invented by him.

And the defendant will prove that Isaac V. Place, James Kent, Joseph Deeacock, and John Stewart, who reside in the town of Johnstown and State of New York, possessed such prior knowledge of the said thing mentioned as aforesaid in said declaration, and that said thing was in public use anterior to the said supposed discovery or invention thereof by said Nathan C. Russell.

SECOND.—Please take notice that, on said trial of this cause,
18 the defendant will prove by Isaac V. Place, John N. Place, James Kent, Joseph Deeacock, George Gillett, Daniel Brower, Purdy Van Vort, John R. Berry, Fred. E. Hotchkiss, Henry C. Day, & Samuel Dodge, all of Gloversville, of the State of New York, and others, that they knew of the use of said thing as substantially the same as the alleged invention of said Nathan C. Russell, and the same, as substantially the same, was used by Isaac V. Place, John N. Place, George Gillett, & Purdy Van Wort, prior to the alleged invention thereof. And the same was, previously to the time when it is claimed the plaintiff invented or discovered the same, in public use, with his consent and allowance, and subsequent to the time when it was claimed he invented or discovered the same.

HIRAM S. PARKHURST,
Defendant's Attorney.

(Endorsed:) United States circuit court, second circuit. Nathan C. Russell against Albert Klein. Plea. H. S. Parkhurst, def't's att'y. Gloversville, N. Y. Filed July 8, 1870.

19 And thereupon the issues above joined came on to be tried at the March adjourned term of said circuit court, held at the city-hall in the city of Utica, on the 3d Tuesday of March, A. D. 1871, before the Hon. Nathan K. Hall, judge, and a jury; and the jurors summoned to try the said issues being empanelled and sworn, after hearing the evidence offered in said causes, do say that they find a verdict in favor of plaintiff, and assess the damages at one hundred and forty-two (142) dollars and fifty cents.

Whereupon it was ordered that defendant have thirty days to make and serve case or exceptions and plaintiff thirty days to prepare amendments, other proceedings to be stayed until the end of next June term.

And the said cause was continued down to the June term of said circuit court, held at the village of Canandaigua, on the 3rd Tuesday
20 of June, A. D. 1871, Hon. Lewis B. Woodruff, presiding judge; at which time and place the said cause came on for a hearing upon a motion for new trial on case & exceptions. And because the said judge, now here, is not yet advised what judgment to give, the said cause is continued until the second Tuesday of October, of the October term of said court, A. D. 1871, at the city-hall in the city of Albany, and the

same day is given to the parties aforesaid, at the same place, to hear the judgment of the said court thereon.

At which said last-mentioned day, before the said judge, at the place last aforesaid, come the parties aforesaid, by their respective attorneys aforesaid; and an order is entered in the words and figures following, to wit:

At a stated term of the circuit court of the United States of America, for the northern district of New York, in the second circuit, held
21 at the city-hall, in the city of Albany, on 2d Tuesday of October, in the year of our Lord one thousand eight hundred and seventy-one.

Present, the honorable Lewis B. Woodruff, judge.

NATHAN C. RUSSELL
vs.
ALBERT KLEIN.

This cause having been heretofore heard on argument by counsel for the respective parties, on motion for a new trial, and the court, having considered the same, ordered that the motion for a new trial be, and the same is hereby, denied with costs.

At a stated term of the circuit court of the United States, held in October, 1871.

Present, Hon. Lewis B. Woodruff, circuit judge.

NATHAN C. RUSSELL
vs.
ALBERT KLEIN.

22 On motion of Mr. Hale, of counsel for def't, after hearing Mr. Smith, of counsel for plaintiff, in opposition, ordered that the def't have leave to turn the case herein into a bill of exceptions.

Enter.

L. B. WOODRUFF,
Circ't Judge.

(Endorsed:) U. S. circuit court, north. dist. of N. Y. Nathan C. Russell vs. Albert Klein. Order. Filed October 26, 1871.

United States circuit court for the northern district of New York, second circuit.

ALBERT KLEIN
ads.
NATHAN C. RUSSELL.

I hereby consent & request that Matthew Hale, esq., of Albany, be substituted in my place as the attorney for the defendant in the above-entitled cause.

Dated January 9th, 1872.

H. S. PARKHURST,
Def't's Att'y.

23 *Bill of exceptions.*

In the circuit court of the United States, northern district of New York.

ALBERT KLEIN
ads.
NATHAN C. RUSSELL.

Afterwards, to wit, at the regular adjourned term of said court, held at the city-hall, in the city of Utica, in and for said northern district of New York, on the 23rd, 24th, & 25th days of March, A. D. 1871, before Nathan K. Hall, esquire, district judge in and for the northern district of New York, duly appointed and authorized to hold said court, according to the form of the statute in such case made and provided, the aforesaid issue, so joined between the said parties as aforesaid, came on to be tried by a jury of the county of Oneida, in said northern district of New York, for that purpose duly empannelled; at which day came there as well the said plaintiff as the said defendant, by their respective attorneys aforesaid. And the jurors of the jury aforesaid,

24 empannelled to try the said issue, being called, and also come, and were then and there in due manner chosen and sworn to try the same issue; and, upon the trial of that issue the counsel for the said plaintiff, to maintain and prove the said issue, gave in evidence certain letters-patent dated February 1, 1870, with specifications and papers; of which letters-patent, specifications, and papers, the following is a copy:

No. 3816. Re-issue.

The United States of America to all to whom these letters-patent shall come:

Whereas N. C. Russell, of Gloversville, New York, has alleged that he has invented a new and useful improvement in the treatment of leather (for which letters-patent were issued to him dated August 17th, 1869, which letters having been surrendered, the same have been cancelled, and new letters ordered to issue to him on an amended specification) and has made oath that he is a citizen of the United

25 States; that he verily believes he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to his knowledge and belief, been previously known or used, has paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents praying that a patent may be issued therefor:

These are, therefore, to grant to the said N. C. Russell, his executors, administrators, or assigns, for the term of seventeen years from the seventeenth day of August, one thousand eight hundred and sixty-nine, the full and exclusive right and liberty of making, using, and vending to others to be used, the said improvements, a description of which is given in the annexed schedule and made a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent-Office to be hereunto affixed. Given under my hand at the city of Washington, on this first day of February, in the year of our Lord one thousand eight hundred and seventy,

26 and of the Independence of the United States of America the ninety-fourth.

W. T. OTTO,
Acting Secretary of the Interior.

Countersigned and sealed with the seal of the Patent-Office.
[L. S.] SAM'L S. FISHER,
Commissioner of Patents.

UNITED STATES PATENT-OFFICE.

Nathan C. Russell, of Gloversville, New York. Letters-patent No. 93910, dated August 17, 1869; re-issue No. 3816, dated February 1, 1870. Improvement in the treatment of leather.

The schedule referred to in these letters-patent and making part of the same.

To all whom it may concern:

Be it known that I, Nathan C. Russell, of Gloversville, in the county of Fulton and State of New York, have invented a new and useful improvement in the preparation of leather, and I do hereby de-
27 clare that the following is a full, clear, and exact description of the same:

My invention consists in a novel treatment of what is known as bark-tanned lamb or sheep skin, an article used by bookbinders, and which, while sufficiently soft and supple for the purposes of their trade, is too hard and stiff for glove-making and a variety of other purposes. This objection is removed by my treatment of the article, and the latter rendered so soft and free, yet full in respect of body, as to adapt it, among other purposes or uses, to the making of what are termed "dog-skin gloves."

The principal feature of the invention consists in the employment of what is known amongst tanners and others as "fat liquor," which is ordinarily obtained by scouring deer-skins after tanning in oil, but which, when it is not convenient to obtain in this manner, may be produced as a liquor having the same character obtained by the cutting of oil with a suitable alkali.

In treating leather with the "fat liquor," it is desireable to heat the latter to or near the boiling-point, and *and* it is preferred to use
28 the same in connection with other ingredients. Thus, for instance, there may be added to each ten gallons (10 gals.) of such heated fat liquor eight ounces (8 oz.) of sal. soda, twelve ounces (12 oz.) common salt, one pint (1 p't) of soft soap, or an equivalent quantity of hard soap, and four ounces (4 oz.) of Venitian red, such ingredients to be well stirred and mixed with the fat liquor.

This forms a good treating mixture or compound, and, when made in the foregoing quantity, will suffice for five or six dozen skins; but, of course, such quantity may be more or less varied, as may also the proportions of the ingredients and the Venitian red, or other coloring-matter, be modified or omitted, as desired.

To effect the treatment hereinbefore referred to, of the bark-tanned lamb or sheep skins, the same should be well dipped in or saturated with the fat liquor, or compound of which fat liquor is the base. This may be done by laying the skin to be treated on a table or other
29 suitable surface, and rubbing the fat liquor or compound on or into both sides of the skin, using for the purpose a horse or other suitable brush or rubber, by which it can be worked into the skin, that is afterward hung out to dry, and subsequently "staked," when the character of said skin will be found entirely changed from hardness to softness, and in other respects, thereby adapting it to the manufacture of gloves of the description previously named, and to a variety of

other purposes for which said skin was not suitable prior to the treatment of it I have herein described.

What is here claimed and desired to be secured by letters-patent is—

1. The employment of fat liquor in the treatment of leather, substantially as specified.

2. The process, substantially as herein described, of treating bark-tanned lamb or sheep skins by means of a compound composed and applied essentially as specified.

N. C. RUSSELL.

Witnesses:
FRED. HAYNES.
FRED. TUSCH.

30 And the said plaintiff then called as a witness JOHN FULTON, who, being sworn, testified that he resided in Gloversville, Fulton County, and was a son-in-law of plaintiff, and had been in business with him in the manufacture of gloves and mittens for five years, and had used the patent, and that he was familiar with the process, and had prepared about two thousand skins according to this process since the patent. Three skins were here produced, which he said were "bark"-tanned sheep-skins in the "bark"-tanned state; also three other skins, which the witness said were the same kind of skins put through the patented process by him, according to the terms of the patent, and that these skins thus produced were fair specimens of the results of the treatment under that process.

That the "bark"-tanned skins were not suitable for making gloves, because they were too hard and harsh, and not pliable, and what the trade called "squeaky;" they were too stiff, and could not be made into gloves; but that, after being subjected to the process described
31 in the patent, they were very sott and pliable, like the skin shown here, and suitable for gloves of all kinds, from the finest to the heaviest.

That before the manufacture of these by plaintiff, the "bark-tanned" were used for gloves very little, but have since been used to a great extent, and there has been a great demand for them in market. The process benefits the skins, on the average, at least two dollars per dozen, and the expense of the process, including materials and labor, does not exceed twelve, or twelve and a half cents a dozen; that the witness never saw bark-tanned skins used at all for gloves or mittens before plaintiff's invention, except for a very cheap article, harvest mittens, or coarse mittens; that the fat-liquor was obtained by putting oil-dressed deer or sheep skins into a liquor made with alkali and water, that cuts the grease; they are then taken from this liquor and put in the stocks and worked by machinery, and in the working comes out this liquor, called fat-liquor; the fat-liquor comes from the skins as they finish the oil-dressed skins in the ordinary way.

32 Being cross-examined, the witness testified that he had been engaged in the manufacture of these gloves for five years; commenced with the plaintiff; made this kind of leather the first year he manufactured, which was five years ago; it was the same kind of leather, but it was not brought to the same state of perfection as it is now; and that year used bark-tan sheep-skins in the manufacture of gloves, and applied fat-liquor to them to make them soft and pliable; made up the gloves and put them in market and sold them; continued to make this kind of leather every year for plaintiff for the past five years, and dressed bark-tanned skins by the application of fat-liquor every year, and put the

goods in market every year; and heated the fat-liquor before applying it five years ago, and every year; never applied it cold; have applied it at or near the boiling point, and it had the effect to burn and spoil the skin if it was at the boiling point; it would not spoil the skin
33 when applied too warm to hold your hand in it. When I first made this kind of goods, and dressed the leather by the application of fat-liquor, no other parties in Gloversville made the same kind of leather in the same way to my knowledge. I think they did not.

In reply to the question "How many manufacturers are there in Gloversville, ?" witness said "I wouldn't say—I counted up the other night, just glancing over, one hundred and ten factories; there are a great many others that manufacture on a small scale." On redirect examination witness testified that prior to his application, for a patent, Mr. Russell experimented with fat-liquor and other ingredients in various ways, which experiments were continued up to or near the spring the application was made, before he got it, as he thought, perfect, and during the time of these experiments the mode of preparation and treatment was kept secret.

DAVID BROWER was then sworn and examined as a witness on behalf of plaintiff, and testified that he had, between March and July, 1869, dressed sixteen dozen sheep and lamb skins under the direction
34 and employment of the defendant, using fat-liquor, sal soda, soap and salt mixed together, heating it up to boiling and then putting in some cold till got cool enough to use, and putting it on the skins with a brush; that it made the leather good and soft, and fit for gloves; that the leather was not fit for gloves before he used this process; it was harsh and stiff, and not very pliable; but this process made it very pliable and soft. That when defendant applied to him to fix these skins, he, defendant told witness he wanted him to fix them and make good leather; make it pliable so that it would cut up into gloves; that he told defendant he did not want to fix the skins on account of Mr. Russell having a patent on them; that if defendant would stand all damages he would go on and make them; and defedant replied. "Go on, make them, you need not be scared, the patent is good for nothing, if they say anything send them to me."

JAMES HEWITSON was also called as a witness for plaintiff, and testified that in June and July, 1870, he had dressed about 60 dozen bark-
35 tanned skins, for defendant, using the same process testified to by Brower as above. That defendant asked him if he could dress skins like Mr. Russell, and he replied that he could, but didn't want to to do it on account of the patent; he told me to take them, that he would take his chances on the patent—the patent was good for nothing; that the skins dressed by him for defendant were bark-tanned skins, not suitable for gloves; they were harsh and had the squeak in them; that after they had been subjected to this process they were soft and pliable, suitable for gloves.

WILLIAM W. WHITAKER was then sworn and examined as a witness for plaintiff, and testified that he resided in Gloversville and was familiar with the skin-dressing and glove-making business, and had been for eighteen or twenty years; that bark-tanned skins, before any other process, were not suitable for gloves, but were too firm and hard;
36 that the leather produced by plaintiff's process was soft, pliable,

and suitable for gloves, and much more valuable for gloves after the process than before; that it increases the value probably about twenty-five per cent., about two dollars per dozen. On his cross-examination, this witness testified that he had known of the application of fat-liquor to leather for the purpose of making gloves eighteen or twenty years; that it had always been in general and common use for all kinds and grades of skins except bark-tanned sheep-skins, to make them soft and pliable, but had never known it to be used on bark-tanned sheep-skins until a year ago; that he had always used fat-liquor for eighteen or twenty years upon all kinds of skins for the purpose of making them soft and pliable and suitable for gloves, and that Indian-dressed skins were dressed entirely with plain fat-liquor. On his redirect examination, witness testified that for the last eighteen or twenty years he had been quite a good deal acquainted with the business of dressing, manufacturing, and selling gloves in Gloversville; that he knew what was in the market generally, and the kinds of gloves
37 produced by the different manufacture's, and that he had never known any bark-tanned skins prepared like these until Mr. Russell's patent, and he thought it could not have been done there to any great extent without his knowledge; that the skins on which the fat-liquor had been used prior to Russell's patent, were oil-dressed skins, not bark-tanned; that he did not know the circumstances under which it was used nor how it was applied.

JOHN FULTON was then recalled by the plaintiff, and testified that there was no other article in the market so cheap, that makes so good a glove as the leather produced by plaintiff's process.

The plaintiff then rested, and thereupon the counsel for the defendant, to maintain and prove the said issue on his part, called as a witness and examined,

WILLIAM H. MONROE, who testified that he had resided in Gloversville, something over seven years, and before removing to Gloversville, resided in Dedham, in the State of Massachusetts for from
38 twelve to fifteen years, and before that in Roxbury, now part of the city of Boston; and was an apprentice in Charlestown; was thirty-nine years of age, and that he learned the trade of tanning and dressing leather in Charlestown, Dedham, and Roxbury; that he had manufactured bark-tanned sheep-skins, that fat-liquor was composed of oil and alkali; that he had used fat-liquor in dressing bark-tanned sheep and lamb skins, for the purpose of making the skins soft and pliable, at different times, all his life; that he first used the process twenty years ago.

Q. How long ago did you first use it?

A. I think about twenty years; I have used it at different times all my life.

Q. For what purpose?

A. For making leather pliable.

Q. Did you make such leather as that I have shown you?

A. I made bark-tan leather like this, and made it pliable.

Q. Did you make it soft as that is?

A. Yes, I made it soft.

Q. Did you take the squeak out of it?

A. Yes, sir.

39 Q. Did you make as good leather as that?

A. Yes; I can make as good leather, or better than that.

Q. I mean now the skins I have shown you; both the plaintiff's and the defendant's?

A. I have made as good leather as I have seen here.

Q. Where did you first make it?

A. In the city of Roxbury, I think, first. That he had no means of ascertaining the number of skins he dressed in that way; that he could not tell how many he had dressed with fat-liquor, because he never approved of or liked it, and seldom used it. I used it at different times, as suited my convenience; perhaps about two thousand skins; that the leather prepared by him was sold to manufacturers of cotton, and used to cover the top roll of spinning-machines, and was not as elastic as the specimens of the plaintiff's leather produced in court; that he made the same kind of leather by the use of fat-liquor first in Gloversville in 1864, and also 1865 and 1866; that in 1864 he dressed about fifty dozen skins by this process, and they were made into gloves and put
40 upon the market and sold. In 1866 he dressed only a few dozen just to show what he could do, and these were the only times he had ever used it in Gloversville, except once in a while he had done a skin to show people; that in Massachusetts he made the fat-liquor himself, which he used, from oil and alkali; in Gloversville used fat-liquor obtained from the mills; that the materials composing the fat-liquor used in Massachusetts were the same as those in that used in Gloversville; that he had used soap in fat-liquor; that the strength of the fat-liquor depended upon the strength of the alkali, as well as on the quantity of water used; that he had used fat-liquor for dressing skins, both heated so as to be comfortable for the hand, and entirely cold.

This witness also testified that he knew the plaintiff, and that he had a conversation with him in 1865, in plaintiff's shop, where plaintiff was working on skins that were already softened up; and witness told plaintiff he (witness) had been softening skins like that. He thought he did it a little better, and plaintiff asked witness what he used,
41 and witness told plaintiff he used fat-liquor, to which plaintiff made no reply. This witness also testified that the bark-tanned skins, dressed with fat liquor by himself at Dedham, and those treated with fat-liquor by him in Gloversville were full as good in respect to softness as those of plaintiff's exhibited on the trial.

On cross-examination this witness testified that he was not a chemist, and did not understand chemistry; that he learned his trade of Smith & Sons, of Dedham, and that it was while employed by them that he made most of the experiments with fat-liquor spoken of in his direct examination; that they were in the business of preparing bark-tanned skins for binding books, *binding books*, and to use on spinning-machines, principally the latter; that the skins were prepared in various ways, sometimes similar to these, and sometimes very different. I think they were mostly prepared similar to these, but not exactly like them; that the fat-liquor used on these was prepared by him, and he could
42 not tell what proportion of alkali and oil he used; that he sometimes used the liquor prepared by him warm, and sometimes cold, just as was convenient; that he never prepared any skins there for gloves; that those he fixed at Gloversville in 1864 were done at the shop of Samuel Dodge, where he tried a dozen different processes, and among the rest dipped some in cold fat-liquor; that he continued to work on Dodge's premises a year, and they occasionally consulted about the matter; that the next time he used the fat-liquor was in 1865, at his shop in Gloversville, where he treated only a few dozen for experiment, and

used the liquor cold; that he made one other experiment in 1866 on a few skins, using cold fat-liquor; that during all the time from 1864 to 1866 he was trying other experiments for the purpose of softening the bark-tanned skins. In 1867 or 1868 he treated half a dozen skins, he thought, with warm fat-liquor; that when he told Mr. Russell about using fat-liquor he did not tell him whether to use it hot or cold;
43 that he was a dealer in bark-tanned skins, and the demand for them increased considerably last year, and there had been a good deal of it used within the last two years.

In reply to the question—

Q. Have you taken considerable interest in this suit?

Witness answered: "I don't know that that concerns you." On a repetition of the question he replied: "Not a great deal."

This witness, also, on the direct examination, on being shown a softened bark-tanned sheep-skin and asked how it was softened, said: "I should judge it might have been with fat-liquor, but it is impossible to tell; there are so many processes that soften the skins, by which they will all appear about alike when they are done, that nobody can tell how they are done."

HARMON KROUSE was then sworn, and examined as a witness for defendant, and testified that he was born in Germany; that he had learned the trade of tanning and dressing skins, and came to
44 this country in 1848; that, in 1857, he was at work for Isaac V. Place, and applied fat-liquor, cold and warm, to bark-tanned skins, for the purpose of making them soft—perhaps 50 or 60 or 100 dozen; that he warmed the fat-liquor before applying it, and applied it both by dipping and with a sponge; that this process made the skins soft and pliable, and they were made into gloves; that Mr. Place had, to witness's knowledge, applied fat-liquor to bark-tanned sheep and lamb skins for six years, he thought. Mr. Place made 300 or 350 dozen bark-tanned gloves in 1862, which, he should think, were prepared with fat-liquor; that he had no hand in preparing them, but saw the skins; that, ever since he had lived in Gloversville, gloves had been made out of bark-tanned sheep-skins; the leather was soft enough to be fit for gloves. On being asked how long this had been the case to his knowledge, witness said he thought Mr. Russell showed him some gloves when he was in the shoe-making business; it might be ten or
45 twelve years ago; he could not say how long. On being asked if he had seen any except what Mr. Russell showed him, witness said Mr. Edwin Duncan showed him some once, and he thought he saw some hanging on Mr. Russell's fence when he lived in Fulton street. He could not say when it was; about ten or twelve years ago; and he might have seen them in various places, passing the street; thought he did.

On his cross-examination this witness testified that, when he worked for Mr. Place, in 1856, they cut up bark-tanned sheep-skins into mittens without any fat-liquor dressing; that whether they warmed the fat-liquor depended on the weather and the time they wanted to spend; that they were made soft enough to do for glove-manufacturing, as they thought, so that they would not break out the sti'ches; that he never prepared any for Mr. Place after 1862, and did not know, of his own personal knowledge, how those in 1862 were prepared; that he did not know, of his own knowledge, how Duncan's skins were prepared.

46 On his redirect examination witness said that fat-liquor had been used in the vicinity of Gloversville from the time he com-

menced work there in 1856, for dressing deer-skin, jacks, hog-skins, fleshers, *potueis* , and all kinds of skins; that he applied it even to woodchuck-skins; but he did not know whether it had been applied cold or hot in dressing deer-skins.

On further cross-examination this witness said that there was a class of leather tanned in oil, called oil-tanned skins, and the manufacture of gloves and mittens in Gloversville was mostly from the oil-tanned and Indian-dressed skins; that the *potueis* , fleshers, jacks, and hog-skins were oil-dressed, and a woodchuck was dressed in alum and sawdust; that the oil-dressed come in the raw, and are tanned or dressed in oil, and this was the use of fat-liquor spoken of by him, except the instances mentioned of its application to bark-tanned skins.

47 SAMUEL DODGE was then sworn and examined as a witness for defendant, and testified that he was fifty-eight years old, and had been working at the trade of tanning and dressing skins into leather since he was seven years old; that he had used fat-liquor in Gloversville and Johnstown upon bark-tanned sheep and lamb skins to make them soft and pliable for twenty-three years, and that leather prepared in that way from bark-tanned sheep and lamb skins had been used by various manufacturers for making gloves for twenty-three years; that he had applied the fat-liquor sometimes warm and sometimes cold; that the object of sometimes warming the fat-liquor, was to make it strike through quicker; sometimes put it on with a brush, and sometimes dipped the skins; that for the past twenty-two or twenty-three years, by the use of fat-liquor, he had made skins as soft as those exhibited on the trial; that he had put soap and sal-soda in sometimes;
48 that he did not want to use salt, and he used sal-soda and soap, simply to make a little more fat-liquor; that he ascertained when it was of a quality fit to use by tasting of it. The witness also testified that some seven or eight years before the plaintiff came to his shop, and asked witness to do some bark-tanned skins for him, and witness told him he had no time, that he had other business to attend to, but that plaintiff could do them as well as witness by putting fat liquor to them, and hanging them out, and that a few days after plaintiff brought some well-softened bark-tanned skins, suitable for gloves, to witness and asked witness to color them for him.

On cross-examination this witness testified that his first use of fat-liquor, in this country, was in Johnstown, in the employment of Jonathan Ricketts, about twenty-three years ago; that while there he worked sometimes on bark-tanned, sometimes on oil-leather; sometimes on kid-leather; that he could give no idea of what proportion of the time
49 he worked on barked-tanned skins, but it was less than one-eighth; that in preparing the bark-tanned skins he used other processes tha nthat of fat-liquor; that he used eggs with the fat-liquor, and something of his own which he did not choose to disclose; that this something was used with the fat liquor, and also with the eggs; that he could give no idea of the proportion of the time he used his secret with the eggs and fat-liquor; that he could give no idea of the proportion of time he used the fat-liquor cold and what warm; that he used the cold in summer and warm in winter; that it was his practice to reduce the fat-liquor with water before using it; that the egg process was considerably more expensive than the fat-liquor; that he remained with Jonathan Ricketts five years, and then removed to Gloversville, and prepared some skins for Churchill, he could not tell how

many, whether five hundred or a thousand; that in doing these he used fat-liquor weakened down, sometimes warm and sometimes cold, and used his secret process in connection with it; that he did an oc-
50 casional job in this way for about three years, when the work fell off, and did no more for four or five years; that since that time, until within the last year or two, he had occasionally done some, but he could not tell when or for whom; that since January, 1871, he had done a hundred or a hundred and fifty dozen, and mostly with the fat-liquor; that he had discontinued the egg process because it was more expensive than the fat-liquor; that when he spoke to Mr. Russell about using fat-liquor, he did not tell him whether to use it cold or hot. The witness also testified that he was a witness on a former trial, under this patent, between Russell and Place, and on being shown the specimens of leather introduced by the defendant, in this case, said that he prepared them for this trial, as follows: First. Dipped them in cold fat-liquor, reduced with water, and kept them in half an hour. Second. Hung them out for over two days to dry: Third. Put them in
51 some new fat-liquor, weakened down; let them remain a quarter of an hour, and worked them up till they go' wet through. Fourth. Put them into a revolving drum in his mill, and worked them for about a quarter of an hour. Fifth. Hung them out, and let them remain about two days to dry. And sixth. Staked them out. Did not use my secret process or any eggs with these.

HENRY HULL was then sworn and examined as a witness for defendant, and testified that he was a tanner and leather-dresser.

Q. Are you acquainted with this bark-tan leather spoken of here?

A. Yes, sir.

Q. Since you have been in Gloversville has that been made into leather suitable for gloves and used for that purpose?

A. Yes, sir.

Q. By the application of what to it?

A. By the application of using fat-liquor and by using soft-soap, eggs, and oil.

52 Q. When first have you known it to be made into leather in that vicinity by the use of fat-liquor?

A. The first time that I used it was in 1857 and 1858.

Q. To what extent?

A. I think I done in the neighborhood of fifty to seventy-five dozen; next used it in 1861, making about 10 or 15 dozen. Used the fat-liquor both warm and cold, but generally cold; applied soap and sal-soda, in 1865, because the fat-liquor was rather too weak; that it sometimes did and sometimes did not succeed in making them soft; that the fat-liquor is just as good cold as warm; there is no difference.

On his cross-examination, this witness testified that the skins he spoke of treating in 1857 and 1858 were done at the shop of David Spalding, for whom he worked; that Arthur Gulick worked there at the same time; that he first tried soft soap and soda on the skins, and that did not work; then he got some fat-liquor and sponged on and dipped
52 a few skins in it; then he hung them up stairs to dry, and after they got dry he brought them down and sponged them again, sometimes repeating the process of sponging and drying three or four times. After the last drying he would dampen them down in a box and let them stay there till the next morning, when he would take them down and moon them, i. e., shave off the flesh side with a circular knife, which process, of itself, makes a skin soft in a certain degree, but won't

kill the squeak; that those he fixed in 1860 or 1861 were dipped in cold liquor, then laid out to dry and then staked; they had already been mooned.

MILES FAIRBANKS was next sworn and examined as a witness for defendant, and testified that he had been a manufacturer of gloves in Gloversville; that he manufactured them mostly of buckskin; that he had prepared bark-tanned skins with fat-liquor exclusively, for the
54 purpose of testing his patterns with; that sometimes he used it warm, when convenient, and when not convenient he used it cold; that it did not soften them like the specimens produced in court; that his skins were whole, and these were split; that it softened them up so that they were suitable for making gloves; that he had seen gloves made from bark-tanned skins softened in Gloversville some 10 or 12 years since he commenced making his dies, and he had used the bark-tanned skins all the time.

This witness also said that he had resided in Gloversville for 40 years, and that the application of fat-liquor to the various kinds of leather used for the manufacture of gloves had been in use there during the whole time; that is, that—where they dressed a quantity of skins and worked them through the process a little too clean, the skins would become tight, flat, thin, they would apply the fat-liquor to them again, which would renew the leather and make them soft again.

On his cross-examination this witness said that he was a die or
55 pattern maker for cutting gloves, and that his use of the fat-liquor was to prepare the skins in some way so as to test his patterns, and that was all the purpose he used it for, except, in 1862, he fat-liquored 100 skins for William Karsanis; the fat-liquor used on Karsanis' skins was warmed and the skins dipped in a tub.

My son got in, and stamped them with his feet, then hung them up to dry, and then staked them out. I never did any after that. This was the largest quantity that I ever experimented on.

On his redirect examination, this witness said that the skins he dressed for Mr. Karson were bark*ed*-tanned, and they made good leather. They were soft when we staked them out.

URIEL CASE was next sworn and examined as a witness for defendant, and testified that, 18 or 20 years ago, he had applied fat-liquor to 20 or 25 dozen bark-tanned skins, dipping some, and applying the liquor with a sponge to others, and this made them soft and suitable for
56 gloves; that he made these skins into gloves, which were sold; used the fat-liquor, both warm and cold. I didn't make any more till last year.

On his cross-examination, this witness testified of the 20 or 25 dozen skins that so he prepared 18 or 20 years ago he could not tell anything about the number of skins treated with warm liquor; that his attention was first called to that old transaction when this suit came off; that he did not know as he ever tried it again until last year, didn't remember whether he did or not; last year there was considerable of it done in Gloversville; that it was a cheaper article than buckskin, and they were making a salable article out of it; that, on the other trial, it was talked in his hearing that there was a large trade, in Gloversville, in gloves made from these bark-tanned skins; that, in 1870, he began to use the fat-liquor to soften bark-tanned skins again.

And the counsel for the plaintiff then asked the witness, "Did Mr. Russell come and forbid you going on?"

57 (This question was objected to by the counsel for the defendant as immaterial and incompetent, and as calling for the declaration of the plaintiff, but the said objection was overruled by the said judge, and the said question held to be admissable, to which ruling and decision of the said judge the defendant's counsel then and there duly excepted,) and the witness answered—

No, sir; he didn't forbid me. He came and asked me if I wasn't interfering with his patent, and he might have told him that he had a way of his own of fixing them; that he did not remember having said anything about its being an old thing, or having been done so twenty years ago; that bark-tanned skins were cheaper than buckskins twenty years ago; that he tried the bark-tanned twenty years ago, supposing them to be cheaper.

ADAM QUACKENBUSH was then called, sworn, and examined as a witness for defendant, and testified that he had resided in Gloversville for twenty-four years; that he had made bark-tanned skins

58 into glove-leather by applying fat-liquor to soften the skins; that it softened the skins some; it made it so that I could use it for mittens and gloves; that he used soap and oil with glove-leather; first used it, in 1856, on about seven dozen skins; then, in 1863, to about ten dozen skins; then, in 1866, to about ten dozen skins; made them into gloves, and sold them; in 1866, used the fat-liquor warm, the others cold; that fat liquor had been used since his residence in Gloversville, more or less, on all oil dressed skins to render them soft.

On his cross-examination, this witness testified that the leather made by him at the various times mentioned in his direct examination was good, but not, in his judgment, as good as the skins of plaintiff produced on the trial; that he never tried the experiment again after 1866 until a little this winter.

59 JOHN W. PLACE was then sworn and examined as a witness for defendant, and testified that he first knew fat-liquor to be used in the treatment of bark-tanned sheep and lamb skins in 1856; made about two hundred dozen of bark-tanned gloves and mittens, that year, from skins treated with fat-liquor, to the best of his recollection; that he put the fat-liquor on cold with a sponge; next used fat-liquor for this purpose in March, 1869; then warmed the liquor, and dipped the skins in; dressed a very few skins in March, 1869. The effect of the fat-liquor, in 1856 and 1869, was to make them soft; have since experimented with fat-liquor, and found that the effect of applying the liquor at or near the boiling point is to spoil the skin entirely; that the effect of boiling the liquor and then cooling it was to separate the greatest portion of the oil, and cause it to rise to the surface; that after it so rises the greasy parts don't mix back, and it leaves greasy specks on the skins.

On his cross-examination this witness testified that he was one

60 of the defendants in the suit tried at Albany, Russell, plaintiff, and his brother, Isaac V. Place, and himself, defendants; that he and his brother were partners and manufacturers at Gloversville; that he was present on this trial as a witness for Kleine without payment of fees, and his brother was present also; that he had seen a paper in reference to the expenses of this suit; it was the day after the trial at Albany in reference to plaintiff's patent; that witness handed it to his

brother, and hadn't seen it since that. Witness copied the paper at his brother's request, and handed it back to him.

(The counsel for plaintiff then asked the witness to state the substance of that paper. This was objected to by defendant's counsel, (1.) Upon the ground that it was not the best evidence. (2.) That no foundation had been laid for the production of the secondary evidence of the contents of the papers in question; and (3) as immaterial and incompetent. But the objection was overruled by the said judge, and the
61 said question held admissable, and the counsel for defendant then and there duly excepted to said ruling and decision of said judge.)

The witness answered: "It was merely in substance to defend the manufacturing interests against Russell's patent. I didn't know who signed it; that the skins prepared in 1856 were just dampened on one side with a sponge, and they made nothing like as nice leather as the specimens of Russell's in court; that the next time he tried the fat-liquor was about two years ago; that he went west in September, 1857, and came back in March, 1866; that he could not say how many they did then; thought twenty-five dozen, but was not positive; that during the year 1870 he and his brother had dressed a good many of the bark-tanned skins—two or three hundred dozen; perhaps more—and made the kind of leather produced in court; that he knew before trying it that the application of fat-liquor in a boiling state to the skins would injure them; that everybody would know that.

62 Defendant's counsel then gave in *in* evidence a certified copy of the original letters-patent to plaintiff, dated Aug. 17, 1869, with the specifications and papers annexed, of which the following is a copy:

No. 93910.

United States of America to all to whom these letters-patent shall come:

Whereas N. C. Russell, of Gloversville, New York, has alleged that he has invented a new and useful improved process of treating leather so as to render it suitable for the manufacture of gloves, &c., and has made oath that he is a citizen of the United States; that he verily believes he is the original and first inventor or discoverer of the said invention, and that the same hath not, to his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents praying that a patent may be issued therefore:

These are therefore to grant to the said N. C. Russell, his ex-
63 ecutors, administrators, or assigns, for the term of seventeen years from the seventeenth day of August, one thousand eight hundred and sixty-nine, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention, a description whereof is given in the annexed schedule and made a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent-Office to be hereunto affixed.

Given under my hand at the city of Washington, this seventeenth day of August, in the year of our Lord one thousand eight hundred and sixty-nine, and of the Independence of the United States of America the ninety-fourth.

W. T. OTTO,
Acting Secretary of the Interior.

Countersigned and sealed with the seal of the Patent-Office.

S. H. HODGES,
Acting Commissioner of Patents.

UNITED STATES PATENT-OFFICE.

Nathan C. Russell of Gloversville, New York, Letters-patent No. 93,910, dated August 17, 1869. Improved process of treating leather so as to render it suitable for the manufacture of gloves, &c.

The schedule referred to in these letters-patent and making part of the same.

To all whom it may concern:

Be it known that I, Nathan C. Russell, of Gloversville, in the county of Fulton, and State of New York, have invented a new and useful improvement in the preparation of leather, and I do hereby declare that the following is a full, clear, and exact description of the same:

My invention consists in a novel treatment of what is known as "bark-tanned lamb or sheep skin," an article used by book-binders and which while sufficiently soft and supple for the purposes of their trade is too harsh and stiff for glove-making and a variety of other purposes.

This objection is removed by my treatment of the article, and the leather rendered so soft and free, yet full in respect of body, as to adapt it, among other purposes or uses, to the making of what are termed "dog-skin gloves."

The process I adopt and which constitutes my invention is as follows: I take of "fat liquor" obtained in scouring deer-skin after tanning in oil, say ten gallons, (10 gal's,) and warm the same by heating to or near the boiling-point. I then add to such heated fat liquor eight ounces (8 oz.) of sal soda, twelve ounces (12 oz.) of common salt, one pint (1 p't) of soft soap, and four ounces (4 oz.) of venitian red, and stir and mix these several ingredients with the fat liquor. This forms the treating mixture or compound, and when made in the foregoing quantity will suffice for five or six dozen skins, but of course such quantity may be more or less varied, as may also the proportions of the ingredients and the venetian red or other coloring matter be modified or omitted as desired. To effect the treatment hereinbefore referred to, of the bark-tanned *or bark-tanned, should* lamb or sheep skins, I lay said skin on a table or other suitable surface, and rub the above-described compound on to both sides of it, using for the purpose a horse, or other suitable brush or rubber by which it can be worked into the skin, that is afterward hung out to dry, and subsequently "staked," when the character of the skin will be found entirely changed from harshness to softness, and in other respects, thereby adapting it to the manufacture of gloves of the description previously named, and to a variety of other purposes for which said skin was not suitable prior to the treatment of it I have herein described.

CLAIM.—What is here claimed and desired to be secured by letters-patent is the process substantially as herein described of treating bark-tanned lamb or sheep skin by means of a compound composed and applied essentially as specified.

N. C. RUSSELL.

Witnesses:
FRED. HAYNES.
M. J. STANLY.

67 The defendant then rested his case, and the plaintiff called as a witness—

CHARLES H. PARTERO, who, being sworn, testified that he resided in Albany, and was a physician and chemist; that he had examined the Russell patent in question and the specifications, and had made tests and experiments in relation to the fat liquor and the process therein described.

The counsel for plaintiff then asked this witness the question: Will you state whether the effect of fat liquor applied to oil-tanned and bark-tanned skins is the same or different?

To this question the defendant's counsel duly objected as immaterial, the purpose for which the process is used being immaterial, if the process is the same.

But the said objection was overruled by the said judge, and the said question held admissable; and to such decision and ruling of the said judge defendant's counsel then and there duly excepted, and the witness answered: That the general effect was the same upon oil-dressed

68 and bark-tanned skins, but the combination was different; that in case of oil-tanned skins the skin consists essentially of gelatime and oil, the substance of the skins, and by the addition of fat liquor to it, the constituents of the fat liquor, especially the soap and the oily matters, were absorbed, while in the case of the bark-tanned skins we have the compound of gelatine and tannin to start with, and with the soapy constituents and the oily matter a new compound was formed; that he thought the compound in the two instances was essentially unlike.

In reply to a question by the court, this witness said that the effect of the treatment with the fat liquor was the same in both cases; that they were different in their properties; they scarcely resemble each other, and the product resulting from the immersion of bark-tanned and oil-dressed skins was undoubtedly different, but that was because the substance subjected to the process was different in the outset; that the effect of the application of the liquor in a heated state was to cause a rapid absorption of the active constituents of the fat liquor; that

69 in the soapy matter and the fatty matter, and pursuing the same method with the cold liquor, a very imperfect absorption of those constituents was obtained, so that two pieces of l'ather which have been placed in the liquor, one with the cold and one with the warm liquor, in the same way, differed very substantially in their properties; that the effect of the heat was to open the pores and render the skin more permeable to the fluid in which it is immersed, and afterward, when it is cooled, the pores contract, the liquor is forced into the minutest pores and the substance of the skin itself; that the effect of heat upon the liquor was, first, to liquify the soapy solution and the oily matter; and, second, to make a more perfect emulsion or more finely divide the oily matter that is contained in the fat liquor, and other things being equal, the emulsion would be the more perfect the higher the degree of heat to which it was raised. If the liquor were heated up to the boiling-point and then cooled, there would not be any appreciable separa-

70 tion between the fatty part and the alkali, and heating up to boiling-point and allowing it to cool, so that a person could work in the liquid would not cause separation to any extent: that if the liquor was heated to the boiling-point and allowed to stand at rest until there was some accumulation on the surface, heating again & agitating would form the emulsion perfectly; and that, in his opinion, heating the liquor to the boiling-point would not destroy the properties of the liquor. If

the skin be treated with cold liquor there would be a tendency to have the oily matter left upon the surface, which coming in contact with the air would form a sticky substance.

On his cross-examination this witness said that if the leather was too hard and stiff for glove-making that objection would be removed by the application of fat liquor, and the effect would be the same, so far as removing that objection was concerned, whether the leather was
71 oil-dressed or bark-tanned; that the constituent parts of fat liquor were water, soda, soap, lime, soap, fatty matter, carbonate of soda, small portions of animal matter & of mineral matter; that fat liquor must vary in strength as desired from different mills and different skins; that if the fat liquor was deficient in alkaline strength, adding sal-soda, soda-ash, soap, or something of the kind, would have the effect of increasing the alkaline strength; that the effect of heating upon fat liquor was the same to whatever extent it was carried.

In reply to a question of the court as to the effect of common salt when added to the fat liquor, witness said: I think it is simply this, that a small portion is absorbed by the skin during the process, and salt is a substance which has the power of absorbing moisture, and I think the main effect is to keep the soapy constituents in a more or less liquid state. Of course the quantity is very minute, but I think it absorbs sufficient moisture to keep the leather more pliant and supple. It makes the pliancy more permanent; that there is generally salt in common soda-ash.

72 CORNELIUS A. KING was then sworn as a witness for plaintiff, and testified that he had been a kid-dresser in Gloversville for about twelve years, and worked for Mr. Dodge in 1862, and for about two years before that; also, from the fall of 1862 till the winter or spring of 1870; and that he never saw any fat liquor used in the preparation of bark-tanned skins at that place. Mr. Dodge used the yolks of eggs for softening the bark-tanned skins.

On cross-examination, this witness said that he did not think that Mr. Dodge could have dressed skins with fat liquor, as testified to by him, without his seeing him. The place was small and everything was going on in a compact shape, and he could see everything that was going on.

ARTHUR GULICK was then sworn and examined as a witness for plaintiff, and testified that he had resided about twenty-five years
73 in Gloversville; had followed the business of cutting gloves and mittens, and had been familiar with the glove and mitten manufacture there generally; had worked from 1852 to 1856 at Spalding's, where the witness Hull worked, and that Hull did not, to witness' knowledge, have any bark-tanned skins dressed with fat liquor while he was there; that he was down through the shops where he worked a good deal at the time; that he worked in the cut'ing-shop, and the leather tanned or dressed in the shop where Hull worked was taken to the cutting-shop, and he saw none while there that were taken in the bark-tanned state and had fat liquor applied to them; that there were a good many bark-tanned skins used that had not been dressed; that he had never known bark-tanned like those of plaintiff produced in court to be produced or used in Gloversville, until within the last two or three years; that skins, after being dressed there, in whatever way, are hung out in public sight on fences, poles, and lines.

74 On his cross-examination, this witness said that he dressed considerably many Indian-dressed skins with fat liquor about twenty years ago, and followed it for a year or two; made them soft and good leather; used saltpetre and sal-soda in the fat liquor; applied it in the winter generally warm; in the summer mostly cold.

JAMES BROWNELL was then sworn and examined as a witness for the plaintiff, and testified that he had been manufacturing mittens and gloves in Gloversville twelve or fifteen years; had been quite familiar with the business and the materials which are used, and had not known this description of leather there, until within the last two or three years, when it had been pretty plenty; that, prior to this time, in his early acquaintance with the business, bark-tanned skins were used in the bark-tanned state for gloves and mittens; made harvest-mittens of them mostly.

75 On his cross-examination, the witness testified that he had known fat liquor to be applied to oil-dressed deer-skins for the purpose of softening them ever since he had known anything about dressing skins.

On redirect examination, this witness testified that the Indian-dressed skins spoken of by him were tanned and dressed in the raw in fat liquor, and the application of fat liquor to other skins referred to by him was to oil-dressed skins where they had been cleaned too much, and the liquor was brushed on to soften them; that he had been so familiar with the business at Gloversville as to be likely to know if the bark-tanned skins like those of plaintiff had been used there to any extent as an article of trade or commerce.

DANIEL S. HEWLITT was then sworn and examined as a witness for the plaintiff, and testified that he had resided for twenty-three years
76 in Gloversville, and worked at leather-dressing and manufacturing, and been familiar during the time with the business there of dressing leather and manufacturing mittens and gloves; and that until recently he had never known a product like plaintiff's leather being used; that if it had been used there to any extent he would have been likely to have known it; that he had dressed and manufactured for himself, bought and sold goods, and kept the run of the market; that split bark-tanned skins in the bark-tanned state were made into harvest-mittens and gloves previously to the last year or two.

THEODORE WELCH was also called as a witness for plaintiff, and testified that he had been for forty years either a manufacturer or peddler of gloves and mittens, and familiar with the manufacture of gloves at Gloversville, and the articles produced, and if this kind of leather had been made there to any extent he should have been likely to have known it; and that he had never seen leather like that produced
77 in court made from bark-tanned skins until within the last two or three years.

The evidence here closed, and the foregoing comprised the substance of all the evidence given relative to the alleged prior use of the process mentioned in the patent, and the novelty and usefulness, character and effect, of the alleged invention of plaintiff; and thereupon the counsel for the defendant did then and there insist before the said judge on the behalf of the said defendant that the said several matters so produced and given in evidence as aforesaid were sufficient, and ought to

be allowed as decisive evidence to entitle the defendant to a verdict, and to bar the said plaintiff of his action aforesaid, and requested the said judge so to rule; to direct the said jury to find a verdict for the defendant; but to this the counsel for the plaintiff did then and there object and insist before the said judge that the same were not sufficient, nor ought to be admitted or allowed to entitle the said defendant
78 to a verdict or to bar the said plaintiff of his action aforesaid, and the judge refused to direct the said jury to find a verdict for the defendant; and to such ruling and refusal of the said judge the counsel for the defendant did then and there duly except.

And the said judge thereupon charged and instructed the jury among other things—

That the person who first invented a new and useful machine, or improvement in a machine, or any new and useful process to be used in the arts or in manufactures, is entitled, upon complying with the provisions of the act of Congress, to obtain letters-patent therefor; but he is required to specify clearly and distinctly what his invention is, and to limit as well as to define the particular invention, the use of which he seeks to secure exclusively to himself. That if he fails to comply substantially with these conditions, and claims in his patent what is not new, or if a substantial or material part of what he claims is not new, then his patent is void.

79 That, taking the re-issued patent as the basis of the plaintiff's claim, the true construction of the first claim is the employment of fat liquor generally, in the state in which it comes from the mills, in the treatment of leather, substantially as described.

That the first claim covered the employment of fat liquor in its pure and simple state.

That the second claim covered the compound substantially as described in the specification, and that the heating of the liquor was an essential portion of the patented process under this claim.

That specifications are not addressed to men entirely ignorant of the manufacture to which the specification relates, but to persons skilled in the art to which it appertains; that if, upon reading this specification, parties skilled in the art of dressing skins would know that this heating was for the purpose of making this compound with the fat liquor or for some other purpose, and that it would not do to apply the fat liquor at or near the boiling-point, because it would destroy the leather, such parties would not be mislead by it, and therefore it would not be
80 a fatal defect; but that, if persons skilled in the art, in attempting to put the plaintiff's invention in practice under this specification, would ordinarily apply the liquor to the skins used while it was at or near the boiling-point, and thus destroy them, then, of course, this specification was bad.

And that if, on the other hand, persons having the knowledge required to carry on the operations necessary to be carried on in similar manufactures and trades, or in the dressing of leather, would not be mislead by it, then it is not objectionable on that ground.

That the jury were to consider the claim of the plaintiff as embracing two distinct and independent things; that the plaintiff had a right, if he was the first and original inventor of the use of fat liquor, in its simple and pure state, in this process, to secure that to himself pure and simple, and to hold, as an infringer, any one who used it without adding the other ingredients that went to make up the compound
81 specified; that he had a right to secure the use of the fat liquor and the other ingredients also, but that the difficulty was, so far

as this case was concerned, that the party having embraced within his claim the use of fat liquor in its pure and simple state, the question of heat or of the use of the compound was not very important to the interests of the parties, because, if the party claimed in his patent what was not new, or a substantial or material part of which was not new, the patent was void.

That, if the jury were satisfied that this process of employing fat liquor in the treatment of leather, as substantially described in the patent, was known, that the process had been perfected, and had been used prior to this time of the plaintiff's invention, and that the persons who used the process had an intelligent comprehension of its character and the effect produced, the patent would be void; and that, upon the question of the validity of the patent, they were to look to the
82 proof in regard to the use of fat liquor, substantially in the manner described when fat liquor alone is used, unconnected with the other ingredients constituting the compound, which is covered by the second claim in the patent; that, if the jury should find that this process had been used prior to plaintiff's alleged invention by other persons, as stated and claimed here, that the persons who used the process were aware of the object and character of it, served and comprehended the beneficial results produced by its use, then the patent would be void upon the ground of want of novelty, although some circumstances might have induced them to abandon temporarily the actual practice of the invention, or the use of the process.

That where an invention has been used in a machine or a process, the patentee may abandon his invention to the public, and he does abandon it if, after two years' use of it, he does not apply for and procure a patent. But that there was a class of cases where parties having made experiments and trials in regard to an invention, either of a proc-
83 ess, composition of matter, or a machine, and finally, not having, in the end, perfected it—not having produced any useful result—they have abandoned it; and then other original inventor who has perfected the invention may come in and claim as the first inventor, and may claim, obtain, and sustain a patent, although it shall appear that the first inventor had proceeded so far in his experiments that there was the merest possible distance between the point he had already reached and success. That, therefore, it was important, in this case, that the jury should determine whether, prior to this alleged invention by the plaintiff, (if that invention was perfected within two years before the application for the patent,) the alleged uses of the process actually took place, and whether there was an intelligent comprehension of the effect of it; in other words, whether the party who used the process had discovered what this plaintiff subsequently patented.

That if they came to the conclusion that the process claimed in the first specification, that is, the fat liquor had been so used sub-
84 stantially as described in the specification before this invention, that was the end of the case.

But if they should come to the conclusion, upon the other hand, that all these other experiments were failures and were abandoned, then, they would come to the question of infringement.

That the proof in regard to the quality and character of leather produced and the knowledge of it at Gloversville and vicinity, and the want of knowledge of it, was proper for the consideration of the jury, in connection with the question of whether these experiments were failures; whether this process was perfected and used; or whether the experiments and trials never reached the point of invention and were

consequently abandoned. But it was not a question whether the result of the use of the process was as perfect at the time as it is now. It was a question whether, substantially, the same process was used.

The plaintiff's counsel then requested the judge to rule and charge the jury that the application of heat to the liquor, and the use of
85 liquor, as described, while in a heated state, are essential parts of the invention or discovery; but it is not, by necessary construction, required by the patent that the liquor should be applied to the skins at or near the boiling heat.

The judge declined to thus rule and charge, on the ground that, under the first claim of the patent, neither the heating of the fat liquor nor the application or use of it, in a heated state, was an essential portion of the process; to which declination and ruling the plaintiff's counsel duly excepted.

The defendant's counsel then requested the said judge to charge the jury that the invention claimed by the plaintiff, as described in the patent of February, 1870, is the treatment of bark-tanned sheep and lamb skins by the employment of fat liquor, and if the jury believe that such treatment was known to others, and more than two years before the plaintiff applied for his patent, his patent is void, and defendant is entitled to a verdict; but the said judge declined to charge as proposed, and declined to alter his charge in that respect, to which refusal the counsel for defendant then and there duly excepted.

86 2. The defendant's counsel also requested the said judge to charge that the proper construction of the patent is that the fat liquor should be applied at or near the boiling-point, and if the jury believe that the application of fat liquor at such a temperature to leather is injurious and pernicious the patent is void for want of utility, and the defendant entitled to a verdict; but the said judge refused so to charge the jury, but modified the said request, and instructed the jury that the proper construction of the second claim of the patent, so far as it relates to the application of heat, is that the compound composed of fat liquor, and the other ingredients required, should be applied at or near the boiling-point, under the common knowledge of persons skilled in the art of treating this leather, to procure softness and pliability, would make them wait until it was partially cooled before its application, and if the jury believe that the application of fat
87 liquor at such a temperature to leather as is required by the specification under this qualification is injurious and pernicious the patent is void for want of utility, and the defendant entitled to a verdict; and the counsel for defendant then and there duly excepted to such refusal and also to such modification of said request as made by said judge.

3. Defendant's counsel also requested the said judge to charge the jury that if the patent did not intend that the fat-liquor be applied to leather when at or near the boiling point, it is, in respect to the application of heat, void for ambiguity; but the said judge refused so to charge the jury for the reasons substantially appearing in the modification of the last preceding request; and to such refusal the defendant, by his counsel, duly excepted.

4. The defendant's counsel also requested the said judge to charge the jury that if the jury believe that cooling the fat-liquor after boiling is an essential point of plaintiff's process, then the patent is void for not indicating that such process of cooling is necessary or how
88 it is to be accomplished; but the said judge refused so to charge the jury, but modified said request by adding thereto the words

"unless the common knowledge of persons skilled in the art of treating this leather to produce softness and pliability would make the operator wait until it was partially cooled before its application," and instructed the jury pursuant to said request as so modified; and the defendant, by his counsel, then and there duly excepted to such refusal, and also to such modification.

5th. The counsel for defendant also requested the said judge to charge said jury that the addition to the fat-liquor of the other ingredients mentioned in the specifications is not patentable if such addition does not change the properties of the fat-liquor, or its effect or usefulness when applied to the purposes mentioned in the patent or specification.

The said judge refused so to charge, but modified said request, and charged that the addition to the fat-liquor of other ingredients
89 mentioned in the specifications is not of itself patentable, if such addition does not change the properties of the fat-liquor or its effect or usefulness, when applied to the purposes mentioned in the patent or specification, or to other like purposes; and the defendant by his counsel then and there duly excepted to such refusal and modification.

6th. The counsel for the defendant also requested the said judge to charge said jury that the process of preparing leather by means of a compound, as claimed by plaintiff, is not patentable, because the proportions of such compound are not fixed, but are in all respects indefinite and uncertain, and may be waived or omitted by the terms of the patent. But the said judge refused so to charge or hold, and the counsel for the defendant then and there duly excepted to such refusal.

7. The counsel for the defendant also requested the said judge to charge the said jury that if the jury shall find from the evidence, that fat-liquor had been used substantially in the manner specified in
90 the plaintiff's patent, for the purpose of rendering any kind of leather soft and supple, more than two years before plaintiff applied for a patent, the plaintiff cannot recover, even though it had not been so used in dressing bark-tanned lamb or sheep skins. But the said judge refused so to charge, and the counsel for defendant then and there duly excepted.

The counsel for the defendant then modified his request, by substituting "used before the plaintiff's invention" for "before the plaintiff applied for a patent," and thereupon the judge charged the jury that the application of an old invention or an old machine to produce a new result, because it is applied to a different material, is not an invention, and the question of novelty is to be determined in the same way. That under the first claim of the plaintiff's, if this particular process was used for the purpose of softening leather, it is not material that it was bark-tanned sheep or lamb-skins, if it be used *in* as a process for that purpose.

91 8th. The counsel for defendant also requested the said judge to charge said jury that if the jury believed that the object of plaintiff's process was to substitute a less valuable article for that commonly known as "dog-skin," and to impose upon the public by representing gloves made of softened sheep and lamb skins as dog-skin gloves, the patent is void for fraud, and plaintiff cannot recover. But the said judge refused so to charge, and the defendant, by his counsel, then and there duly excepted to such refusal. But the said judge charged that if the process patented could not be made useful for any honest purpose, but only for perpetrating a fraud upon the public, and was therefore not useful, but pernicious, the plaintiff could not recover.

9. And the counsel for defendant also requested the said judge to charge said jury, that if anything claimed by the plaintiff in his patent, as used, was in fact old, the entire patent was void, and plaintiff could not recover. But the said judge declined so to charge the said jury, except as had already been charged in the portion of the charge of said judge hereinbefore stated; and to such refusal the defendant, by his counsel, then and there duly excepted.

92

10. The counsel for the defendant also requested the said judge to charge said jury that the patent could not be sustained in the matter of the mere degree of heat, if the principle of applying heat to any extent is an old process. But the said judge declined so to charge, except as had already been charged in the portion of the charge hereinbefore set forth; and to such refusal the counsel for defendant then and there duly excepted.

And the said judge, under the charge and with the directions aforesaid, left the aforesaid issue and the evidence so given on the trial thereof, as aforesaid, to the said jury, and the jury aforesaid then and there gave their verdict for the said plaintiff, and one hundred and forty-two dollars and fifty cents damages; and inasmuch as the said several matters so produced and given in evidence on the part of the said defendant, and by his counsel aforesaid objected and insisted on as a bar to the action aforesaid, and the said exceptions so offered and made to several decisions and rulings of the said court, do not appear by the record of the verdict aforesaid, the said counsel for the defendant did then and there propose their aforesaid exceptions to said decisions and rulings of the said judge; and thereupon the said judge, at the request of the said counsel for the defendant, hath to this bill of exceptions put his seal, according to the statute in such cases made and provided, as of the 25th day of March, in the year one thousand eight hundred and seventy-one.

93

N. K. HALL. [L. S.]

I suppose the defendant may wish to move for a new trial on the foregoing bill, and for that purpose I sign it as it is, as it will then have substantially the effect of a case. If the case is to go up on a writ of error the bill should be re-issued, and much if not most of the statements of the oral testimony be stricken out, as well as the larger portion of the judge's charge.

H.

(Endorsed:) Circuit court of the U. S., northern dist. of N. Y. Albert Klein ads. Nathan C. Russell. Bill of exceptions. Matthew Hale, def't's at'y, Albany, N. Y. Filed March 11, 1872.

94

Wherefore it is considered that the said plaintiff, Nathan C. Russell, do recover against the said defendant, Albert Klein, the sum of one hundred and forty-two (142) dollars and fifty (50) cents, besides costs taxed at two hundred and eighty one (281) dollars and ninety-six (96) cents, which in the aggregate amounts to four hundred and twenty-four (424) dollars and forty-six (46) cents; and that execution issue therefor.

Judgment signed this 18th day of March, A. D. 1872.

CHARLES MASON, *Clerk.*

(Endorsed:) U. S. circuit court north. dist. of N. Y. Nathan C. Russell vs. Albert Klein. Judgment record. H. E. Smith, pl'ff's at'y. Damages, $142.56; taxed costs, 281.96. Judgment, $424.46. Filed March 18, 1872, 4 o'clock p. m.

95 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the judges of the circuit court of the United States for the northern district of New York, greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said circuit court, before you, or some of you, between Nathan C. Russell and Albert Klein, a manifest error hath happened, to the great damage of the said Albert Klein, as is said and as appears by his complaint: We being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the justices of the Supreme Court of the United States, at the Capital, in the City of Washington, together with this writ, so that you have the same at the said place, before the justices aforesaid, on the first Monday of December next, that the record and proceedings aforesaid being inspected, the said justices of the Supreme Court may cause further to be done therein, to correct that error, what of right and according to the law and custom of the United States ought to be done.

Witness the Honorable Salmon P. Chase, Chief Justice of the Supreme Court of the United States, this 4th day of December, in the year of our Lord one thousand eight hundred and seventy one, and of the Independence of the United States the ninety-sixth.

[SEAL.] CHARLES MASON,
Clerk of the Circuit Court of the United States of America, for the Northern District of New York, in the Second Circuit.

96 (Indorsed:) U. S. Supreme Court. Albert Klein, pl'ff in error, ag't Nathan C. Russell, def't in error. Writ of error. Matthew Hale, att'y for pl'ff in error, Albany, N. Y.

Allowed March 25th, 1872.

S. B. WOODRUFF,
Circuit Judge.

Filed March 26, 1872.

97 Supreme Court of the United States.

ALBERT KLEIN *ads.* NATHAN C. RUSSELL.

Know all men by these presents that we, Albert Klein, principal, and Isaac Place and Samuel Dodge senior, all of Gloversville, Fulton County, New York, sureties, are held and firmly bound unto Nathan C. Russell, of Gloversville, in the county of Fulton, State of New York, in the sum of two thousand dollars, to be paid to the said Nathan C. Russell, his executors or administrators, to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our heirs, executors, and administrators, firmly by these presents, with our seals, dated this 23d day of March, 1872.

Whereas the above-named Albert Klein hath prosecuted a writ of error to the Supreme Court of the United States to reverse the

98 judgment rendered in the above-entitled action by the circuit court of the United States for the northern district of New York, March 18, 1871, for $424.46:

Now, therefore, the condition of this obligation is such that if the above-named Albert Klein shall prosecute his said writ of error to effect, and answer all costs and damages, if he shall fail to make good his plea, then this obligation shall be void; otherwise to remain in full force and virtue.

ALBERT KLEIN. [SEAL.]
ISAAC V. PLACE. [SEAL.]
his
SAMUEL × DODGE, SENIOR. [SEAL.]
mark.

Witness:
NATHAN SWART.
AMASA J. PARKER, JR.

UNITED STATES OF AMERICA,
Northern District of New York, ss:

Isaac V. Place and Samuel Dodge, senior, being duly and severally sworn, say and each for himself says, that he is a resident & freeholder of & within the said district, to wit, of the county of Fulton, in said district, and is worth the sum of two thousand dollars over and
99 above all his debts and liabilities & besides his property exempt by law from execution.

ISAAC. V. PLACE.
his
SAMUEL + DODGE, SENIOR.
mark.

Sworn to before me this March 23, 1872.
[L. S.] AMASA J. PARKER, JR.
U. S. Com'r N. D. of N. Y.

UNITED STATES OF AMERICA,
Northern District of New York, ss:

On the 23d day of March, 1872, before me, a United States commissioner in and for said district, came Albert Klein, Isaac V. Place, & Samuel Dodge senior, to me well & personally known to be the same persons mentioned & described in the foregoing instrument, & severally acknowledged that they executed the same.

[L. S.] AMASA J. PARKER, JR.,
U. S. Commissioner in & for N. D. of N. Y.

Approved by—

S. B. WOODRUFF,
Circuit Judge.

MARCH 25, 1872.

100 (Indorsed:) Supreme Court of the United States. Albert Klein, pl'ff, in error, ag't Nathan C. Russell, def't in error. Copy bond. Matthew Hale, att'y for pl'ff in error, Albany, N. Y. Filed March 26, 1872.

101 United States Supreme Court.

ALBERT KLEIN, PL'FF IN ERROR,
vs.
NATHAN C. RUSSELL, DEF'T IN ERROR.

NORTHERN DISTRICT NEW YORK, *ss:*

On this 29th day of March, A. D. 1872, personally apeared Jerry Keck, before me, the subscriber, and makes oath and says, that he served the annexed citation on H. E. Smith, esq., the attorney for the defendant in error, in the above cause, by delivering to and leaving with him at his office in Johnstown, in said northern district of New York, a true copy of said annexed citation.

JERRY KECK.

Subscribed and sworn this 29th day of March, A. D. 1872.
[SEAL.] JAMES M. DUDLEY,
United States Commissioner for the Northern District of New York.

102 UNITED STATES OF AMERICA, *ss:*

To Nathan C. Russell, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States to be holden at Washington, on the first Monday of December next, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the northern district of New York, wherein Albert Klein is plaintiff, and you are defendant, in error, to show cause, if any there be, why the judgment in the said writ of error, mentioned should not be corrected, and speedy justice should not be done to the parties in that behalf.

Witness the Honorable Salmon P. Chase, Chief Justice of the said Supreme Court of the United States, this 25th day of March, one thousand eight hundred and seventy-two.

S. B. WOODRUFF,
Circuit Judge of the United States.

103 (Indorsed:) Supreme Court of the United States. Albert Klein, pl'ff in error, ag't Nathan C. Russell, def't in error. Citation & proof of service. M. Hale, att'y for pl'ff in error, Albany, N. Y. Filed April 1, 1872.

104 UNITED STATES OF AMERICA,
Northern District of New York, ss:

I, Charles Mason, clerk of the circuit court of the United States of America for the northern district of New York, do hereby certify that I have compared the writings annexed to this certificate, and they are true copies of their respective originals, and are correct transcripts therefrom, now on file and remaining of record in my office, being a full and complete copy of the record and proceedings in the suit of Nathan C. Russell vs. Albert Klein.

In testimony whereof I have hereunto set my hand, and duly affixed the seal of the said court, at the city of Utica, in said district, this 10th day of June, A. D. 1872.

[SEAL.] CHARLES MASON, *Clerk.*

(Indorsement on cover:) No. 396. Albert Klein, plaintiff in error, vs. Nathan C. Russell. N. New York C. C. U. S. Filed 15th June, 1872.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

ALBERT KLEIN, PLAINTIFF IN ERROR,

against

NATHAN C. RUSSELL.

BRIEF OF PLAINTIFF IN ERROR.

MATTHEW HALE, JAMES M. DUDLEY,
Of Counsel for Plaintiff in Error.

ALBANY:
THE ARGUS COMPANY, PRINTERS.
1874.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

ALBERT KLEIN, PLAINTIFF IN ERROR,

against

NATHAN C. RUSSELL.

BRIEF OF PLAINTIFF IN ERROR.

MATTHEW HALE, JAMES M. DUDLEY,
Of Counsel for Plaintiff in Error.

ALBANY:
THE ARGUS COMPANY, PRINTERS.
1874.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

ALBERT KLEIN, PLAINTIFF IN ERROR,
vs.
NATHAN C. RUSSELL.

Brief of Plaintiff in Error.

STATEMENT OF THE CASE.

This case comes before the court on a writ of error to the Circuit Court for the Northern District of New York.

The action was brought to recover for an alleged infringement of a patent for an alleged new and useful improvement in the treatment of leather. The defendant pleaded the general issue and gave notices of special matter under the statute.

The notices were that defendant would prove that the plaintiff was not the original inventor of the alleged improvement, but that the principle patented was known to and used by various persons named, and was in public use for more than two years prior to the application of the plaintiff for a patent. (First notice, fol. 15; second notice, fol. 18.)

The patent under which the plaintiff below claimed was a reissue; the original patent was issued August 17, 1869;

the reissue February 1, 1870. The first or original patent may be found at fol. 64. It describes a compound consisting of "fat liquor" and other ingredients, and the claim therein is as follows: "What is here claimed and desired to be secured by letters patent is the process substantially as herein described of treating bark-tanned lamb or sheep skin by means of a compound composed and applied essentially as specified." (Fol. 66.)

The reissue (fol. 27) states that the "principal feature of the invention consists in the employment of what is known amongst tanners and others as 'fat liquor,' which is ordinarily obtained by scouring deer skins after tanning in oil, but which, when it is not convenient to obtain in this manner, may be produced or a liquor having the same character obtained by the cutting of oil with a suitable alkali." The patent then proceeds to say that in treating leather with the fat liquor, it is *desirable* to heat it to or near the boiling point, and it is *preferred* to use it in connection with other ingredients, which are specified, and which are precisely the same as those mentioned in the original patent. The following is the claim in the reissue: "What is claimed and desired to be secured by letters patent is: (1.) The employment of fat liquor in the treatment of leather, substantially as specified. (2.) The process, substantially, as herein described, of treating bark tanned lamb or sheep skins by means of a compound composed and applied essentially as specified." (Fol. 29.)

The case was tried before Judge Hall and a jury at Utica in March, 1872. At the close of the evidence, the counsel for the defendant below requested the court to direct a verdict for the defendant, but such request was denied and the defendant below excepted. (Fol. 78.) The defendant below also made several requests to charge, upon various questions involving the construction of the patent and the effect of the evidence of prior use, etc., which requests were refused or modified, and exceptions taken by defendant.

ASSIGNMENT OF ERRORS.

I. The Circuit Court erred in refusing to direct the jury to find a verdict for the defendant below, when thereto requested. (Fol. 78.)

II. The Circuit Court erred in refusing to rule and charge the jury, when requested thereto, that the invention claimed by the plaintiff below, as described in the patent of February, 1870, was the treatment of bark-tanned sheep and lamb skins by the employment of fat liquor, and if the jury believed that such treatment was known to others, and more than two years before the plaintiff below applied for his patent, his patent was void, and the defendant below entitled to a verdict. (Fol. 85.)

III. The Circuit Court erred in refusing to rule and charge the jury, when thereto requested, that the proper construction of the patent was that the fat liquor should be applied at or near the boiling point, and that if the jury believed that the application of the fat liquor at such a temperature to leather was injurious and pernicious, the patent was void for want of utility, and the defendant below entitled to a verdict; and also in modifying said request, and charging the jury that the proper construction of the second claim of the patent, so far as related to the application of heat, was that the compound should be applied at or near the boiling point, unless the common knowledge of persons skilled in the art of treating leather would make them wait until it was partially cooled before its application. (2d request, fol. 86.)

IV. The Circuit Court also erred in refusing to charge the jury, that if the patent did not intend that the fat liquor be applied to the leather, when at or near the boiling point, it was, in respect to the application of heat, void for ambiguity. (3d request, fol. 87.)

V. The Circuit Court also erred in refusing to charge the jury, when requested, that if they believed that cooling the

fat liquor after boiling was an essential point of plaintiff's process, then the patent was void for not indicating that such process of cooling was necessary, or how it was to be accomplished; and also in modifying such request, by adding the words as to the common knowledge of persons skilled in the art of treating leather. (4th request, fol. 88.)

VI. The Circuit Court also erred in refusing to charge the jury, when requested, that the addition to the fat liquor of the other ingredients, mentioned in the specifications, was not patentable, if such addition does not change the properties of the fat liquor, or its effect or usefulness, when applied to the purposes mentioned in the patent or specification; and also in modifying such request, by adding thereto the words, "or to other like purposes," and in charging the request as so modified. (5th request, fols. 88, 89.)

VII. The Circuit Court also erred in refusing to charge the jury, when thereto requested, that the process of preparing leather by means of a compound, as claimed by the plaintiff below, was not patentable, because the proportions of such compound were not fixed, but were, in all respects, indefinite and uncertain, and might be waived or omitted by the terms of the patent. (6th request, fol. 89.)

VIII. The Circuit Court also erred in refusing to charge the jury, when thereto requested, that if the jury should find from the evidence that fat liquor had been used substantially in the manner specified in the plaintiff's patent for the purpose of rendering any kind of leather soft and supple, more than two years before the plaintiff below applied for a patent, the plaintiff below could not recover, even though it had not been so used in dressing bark-tanned lamb or sheep skins. (7th request, fol. 90.)

IX. The Circuit Court also erred in refusing to charge the jury, when requested, that if they believed that the object of plaintiff's process was to substitute a less valuable article for that commonly known as "dog skin," and to impose upon the public by representing gloves made of

softened sheep and lamb skins as dog-skin gloves, the patent was void for fraud, and the plaintiff below could not recover. (8th request, fol. 91.)

X. The Circuit Court also erred in refusing to charge the jury, when requested, that if anything claimed by the plaintiff below in his patent as new, was in fact old, the entire patent was void, and plaintiff could not recover. (9th request, fol. 92.)

XI. The Circuit Court also erred in refusing to charge the jury, when requested, that the patent could not be sustained in the matter of the mere degree of heat, if the principle of applying heat to any extent was an old process. (10th request, fol. 92.)

XII. The Circuit Court erred in permitting the plaintiff below on the trial, notwithstanding the defendant's objection and exception, to ask the witness, Uriel Case, on his cross-examination, the question, "Did Mr. Russell come and forbid your going on?" and in admitting, in answer thereto, evidence of a declaration of the plaintiff below. (Fol. 57.)

XIII. The Circuit Court erred in permitting the plaintiff below to give parol evidence of the contents of a certain paper in reference to the expenses of defending the suit, notwithstanding the objection and exception of the defendant below. (Fols. 60, 61.)

XIV. The Circuit Court erred in permitting the plaintiff below, notwithstanding the objection and exception of defendant, to ask the witness, Charles H. Porter, whether the effect of fat liquor applied to oil-tanned and bark-tanned skins was the same. (Fol. 67.)

POINTS.

First. The court below erred in refusing to direct a verdict for the defendant.

I. The reissued letters patent are void, because they were not granted for the *same invention* as that embodied in the original letters patent.

1. Whenever any patent is inoperative or invalid by reason of a defective or insufficient description or specification, if the error arose by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it is lawful for the commissioner, upon the surrender to him of such patent, and the payment, etc., to cause a new patent to be issued to the inventor for the *same invention* for the residue of the term then unexpired, in accordance with the patentees, corrected description and specification.

5 Stat. at Large, 122.

Reissued letters patent must, by the express words of the statute, be for the *same invention*, and, consequently, when it appears, on a comparison of the two patents as matter of legal construction, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid, as that state of facts shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Interpolations of new features, ingredients or devices, which were neither described, suggested nor indicated in the original patent or patent office model, are not allowed, as it is clear that the commissioner has no jurisdiction to grant a

reissue unless it be for the same invention as that embodied in the original letters patent.

Seymour v. Osborn, 11 Wallace, 544, 545, 546.
Sickles v. Evans et al., 2 Clifford, 203, 222.

And this is a question of law, to be decided by the court.

Id.

2. Upon the face of the original and reissued patents, upon comparison, it appears as matter of law that they are not for the same invention, and hence the reissued patent is void.

(*a.*) The original patent had but one claim, substantially the same as the second claim in the reissued patent.

(*b.*) This was for the treatment of bark-tanned lamb and sheep skins (not leather) with the same compound as in the reissue.

(*c.*) The patentee states in his original specification that it is "a full, clear and exact description" of the invention. That "his invention consists in a novel treatment of bark-tanned lamb or sheep skins." That "the process he adopts and which constitutes his invention is as follows." Here stating the ingredients of the compound and

proportions, substantially as stated in the reissue, and describing only the mode of applying the compound to the skin, of crushing it into the skin, as described in the reissue, closing with the claim stated.

In the comparison it will be seen that the original claimed only the treatment of bark-tanned lamb and sheep skins with the specific compound brushed or rubbed on, neither describing, suggesting nor indicating the treatment of leather generally at all, nor such skins with fat liquor alone without said ingredients, nor the saturating by dipping. Upon the face of the two patents the old was for treatment with the *compound* alone, and the reissue is primarily for treatment with *simple fat liquor* alone, stating only that the patentee "*preferred* to use the same in connection with other ingredients;" and, after describing the compound, stating that "this forms a good treating mixture or compound," and closing with the second claim. It is simply for such treatment with simple fat liquor as it comes from the mill (which is no way indicated in the original), interpolated with the sole treatment and sole claim specified in the original,

which is now suggested only as a "preferable" way, and secondary to that of fat liquor alone.

3. The specification does not contain the whole truth, but contains more than is necessary to produce the described effect, which fully appears to have been made for the purpose of deceiving the public, and on that account the patent is void.

Stat. 1870, ch. 230, § 61.

(*a.*) It conceals the fact established by the evidence as well known in the trade that fat liquor alone had been long used for softening leather. See next subdivision.

(*b.*) It conceals the fact that the applicant knew generally of the use of fat liquor for said purpose long before obtaining his original patent, and that with such *knowledge* he obtained his patent for treatment with the *compound only*.

II. The claim of the plaintiff below, under his reissued patent, consists essentially in the employment of "fat liquor" for the purpose of rendering leather soft and suitable for glove making and other purposes, for which hard and stiff leather is not suitable. This is in fact all there is of the patent. Certainly it is a substantial and material part of it.

The statement that it is *desirable* to heat the liquor and *preferred* to use it with certain ingredients named, is not a *specification* of the means

to be used, sufficient to sustain a claim that the use either of the *heated* liquor, or the *compound* liquor, is patented.

See opinion of Mr. Justice Hunt, in the case of Russell v. Dodge, annexed hereto as part of this brief.
Also, Booth v. Kinnard, 1 Hurlst. & N., 527.
Curtis on Patents, §§ 143, 258.
Stevens v. Keating, 2 Web. Pat. Cases, 172.

Defendant was entitled to a verdict, if the use of fat liquor to render leather "soft and supple" was known and in public use prior to plaintiff's alleged invention.

Parker v. Stiles, 5 McLean, 54.
Parker v. Sears, 1 Fisher, 99.
Smith v. Downing, Id., 70.
Pitts v. Hall, 2 Blatch., 234.
Holliday v. Rheim, 18 Penn. St., 469.
Evans v. Eaton, 7 Wheat., 434.
Chap. 357, of 1836, § 15.

III. If fat liquor had been used for two years prior to plaintiff's application for a patent, in the manner indicated, for the purpose of rendering *any kind* of leather soft and supple, his patent cannot be sustained, even if it had not before been applied to "bark-tanned" skins.

Bean v. Smallwood, 2 Story, 411.
Le Roy v. Latham, 14 How., 177.
Hovey v. Henry, Law's Dig., 432, No. 27.

IV. The evidence was clear and uncontradicted, that the use of "fat liquor," for the purpose of softening leather and in the manner, substantially, mentioned in the letters patent, had been known and in almost universal use, among

manufacturers of leather, for many years prior to plaintiff's alleged invention. Indeed, plaintiff himself never pretended but that the process itself was used, except so far as such a claim is made in his letters patent. Its application to "bark-tanned" leather was *his* pretended discovery.

The bill of exceptions contains the substance of all the evidence given relative to the prior use of the process mentioned in the patent, and the novelty and usefulness, character and effect of the alleged invention. (Fol. 77.)

Every witness examined on the subject, called on either side, agreed that the application of fat liquor to leather for the purpose of making it soft and pliable, to use in glove making, had been known and in general and common use for many years.

Whitaker's evidence, folio 36.
Monroe's evidence, folio 38.
Krouse's evidence, folio 44.
Dodge's evidence, folio 47.
Hull's evidence, folio 51.
Fairbank's evidence, folio 54.
Case's evidence, folio 56.
Quackenbush's evidence, folio 58.
Place's evidence, folio 59.
Gulick's evidence, folio 74.
Brownell's evidence, folio 75.

Some of the witnesses called on the part of the defendant in error, it is true, swore that they did not know of its use in the treatment of *bark-tanned* skins. But, as has before been shown, the *process* being the same, the kind of skins to which it was applied is immaterial. And if it *were* material, the positive knowledge of the witnesses Monroe, Krouse, Dodge, Hull,

Fairbanks, Case, Quackenbush and Place, that it had been applied to bark-tanned skins, is not contradicted by a mere want of knowledge on the part of some other witnesses.

And the fact of this prior use being undisputed, and being fatal to the right of the defendant in error to recover, it was the duty of the court to direct a verdict for the plaintiff in error.

Waldbrunn v. Babbit, 16 Wall., 577.
Bevans v. U. S., 13 id., 56.

SECOND. The court below erred in refusing to charge the jury that the invention claimed by the plaintiff below, in his reissued patent, was the treatment of bark-tanned sheep and lamb skins by the employment of fat liquor; and that if they believed that such treatment was known to others, and more than two years before the plaintiff applied for his patent, his patent was void, and the defendant (below) entitled to a verdict. (Fol. 85.)

I. The construction of the patent, as indicating only the use of *fat liquor* in dressing leather, whether hot or cold, alone or with other ingredients, as the alleged invention of the defendant in error, has already been shown to be the true one by the first point above, and by the opinion of Mr. Justice Hunt, already referred to.

Indeed, the defendant in error having, in surrendering his original patent and procuring the reissue, necessarily sworn that the original patent was *inoperative and invalid* by reason of a defective or insufficient specification, and the original patent having described a compound precisely like that recommended in the reissue and, as is shown in Mr. Justice Hunt's opinion,

indicated much more clearly than the reissue, that the application of heat was an essential element in this invention, he is now estopped from claiming that the same identical thing recommended in the specification and second claim of the reissue is valid and operative. (See Moffat v. Gan, 1 Fisher, 613.) Unless the defendant in error was the *inventor* of the use of *fat liquor* for the purpose indicated, he took nothing by the reissue.

II. The second branch of the request, that knowledge of this treatment by others more than two years before *plaintiff applied for his patent* rendered the patent void, was also correct.

Ch. 357 of 1836, § 15.
Ch. 88 of 1839, § 7.
16 Stat. at Large 208, § 61.

The charge of the court had limited the effect of knowledge by others to two years before the *alleged invention* (fol. 83), which was erroneous.

THIRD. The court below also erred in refusing the requests to charge in relation to the construction of the patent, so far as it related to the application of heat, and in modifying said requests as above stated. (2d, 3d and 4th requests, fols. 86 to 88.)

1. The patent recommended that the fat liquor be heated " to or near the boiling point." (Fol. 28.) The natural inference was that it was to be applied in that condition. If applied at such temperature, there was evidence that it would be *destructive* to the leather. (Fol. 59.) But the

judge refused to instruct the jury that the patent was void for want of utility, if they believed this evidence, except with a modification, which really left the construction of the specification in the patent to the jury. (Fol. 87.)

2. We insist (under the 3d and 4th requests) that the specification in the patent either required the liquor to be applied at or near boiling heat, or else utterly failed to specify at what heat it should be applied, and that for this reason the patent was void in respect to the application of heat.

See Tyler v. Boston, 7 Wall., 327.

FOURTH. The court below erred in refusing to charge as requested, with reference to the patentability of the addition to the fat liquor of the other ingredients mentioned in the specifications, and in modifying the request by adding thereto the words "or other like purposes." (Fol. 89.) The "purposes" of the process are clearly set forth in the patent. They were to remove the hardness and stiffness of bark-tanned skins. The evidence was that the other ingredients named in the patent did not change the properties of "fat liquor," which is simply *oil cut with alkali*. (See fols. 27, 71.)

Defendant was entitled to a charge, that if the ingredients named when added did not change the properties of fat liquor, or its effect or usefulness when applied to *the purposes mentioned in the patent or specification*, such addition was not patentable. The words "or other like purposes," added by the court, left the jury to *conjecture* that, for *some other* purpose than making leather soft and pliable, the addition of these ingredients might change the effect of the fat liquor and be patentable.

FIFTH. The court erred in refusing to charge that the process of preparing leather by means of a compound, as claimed by plaintiff, was not patentable, because the proportions were not fixed, but were indefinite and uncertain, and may be waived or omitted by the terms of the patent. (6th request, fol. 89.)

By referring to the specification in the patent, it will be seen that this request should have been complied with. "It is *preferred* to use the same in connection with other ingredients." (Fol. 28.) Then after giving certain proportions, it goes on to say, "but of course such quantity may be more or less varied, as may also the proportions of the ingredients, and the venetian red or other coloring matter, *be modified or omitted* as desired." (Fol. 28.)

In other words, everything was left to the taste and fancy of the user, who was at liberty, under this patent, to use any or all these ingredients in such proportions or manner as he pleased, or to omit them altogether.

It is absurd to say that such a use, or omission to use, of well-known ingredients was patentable. The description of the pretended "compound" was too vague and uncertain to sustain a patent.

Tyler v. Boston, 7 Wall., 327.
Wood v. Underhill, 5 How., 1.
Parker v. Stiles, 5 McLean, 54.

SIXTH. The court below erred in refusing to charge the jury that if fat liquor had been used substantially in the manner specified in the plaintiff's patent, for the purpose of rendering *any kind* of leather soft and supple, more than two years before plaintiff applied for a patent, the plaintiff below could not recover, even though it had not been so used in dressing bark-tanned lamb or sheep skins. (7th request, fol. 90.)

This request was conceded by the learned judge to

be correct in principle, so far as it referred to the use of the process for the purpose of softening any leather, but he refused to charge that such prior use for two years before the plaintiff below *applied for his patent*, was sufficient.

See statutes above referred to.

And upon the general principle involved in the request, see

Harwood v. The Great No. Railway, 11 H. of Lds. Cases, 654.
Hotchkiss v. Greenwood, 11 How., 248, 264.
Bean v. Smallwood, 2 Story, 408, 411.
Winans v. Boston & Prov. R. R., 2 id., 412 415.
Losh v. Hague, Web. Pat. Cases, 202, 207, 208.
Regina v. Cutler, 3 Car. & Kir., 215, 228, 230, 234.
Jordan v. Moore, L. R., 1 C. P., 624.
Brooks v. Aston, 8 El. & Bl., 478, 485.
Howe v. Abbott, 2 Story, 190, 193, 194.
Phillips v. Page, 24 How., 164, 167.
Bottle Envelope Co. v. Gymer, 5 C. B. (N. S.), 164.
Bush v. Fox, 5 H. of Lds. Cases, 707, 715, 716.
Leroy v. Latham, 14 How., 177.
Baulton v. Bull, 2 H. Bl., 487.

The fact that the chemical combination of fat liquor with bark-tanned skins may be different from its combination with oil-dressed leather, as claimed by Dr Porter, does not change the rule, since he states, and all agree, that the general effect is the same upon all skins or leather, namely, to make them soft and pliable.

SEVENTH. The court below erred in refusing to charge, when requested, that if anything claimed by the plain-

tiff in his patent as new was, in fact, old, the entire patent was void, and the plaintiff could not recover. (Ninth request, fol. 92.)

See cases cited under first point (*supra.*)

EIGHTH. The court below erred in refusing to charge the jury that the patent could not be sustained in the matter of the mere *degree* of heat, if the principle of applying heat to any extent was an old process. (Tenth request, fol. 92.)

Several witnesses had testified that they had used warm fat liquor for the purpose mentioned in the patent, but none testified to having heated it "to or near the boiling point," as recommended in the specification of the patent. (See fols. 40, 44, 47, 52, 54, 56, 58, 59.)

The request was, in effect, that the raising the heat of the fat liquor to the *boiling point* did not of itself constitute an invention which was the subject of a patent, and the defendant below was entitled to this instruction.

Brooks v. Bicknell, 3 McLean, 262.
McCormick v. Manny, 6 id., 557.
Everson v. Ricard, Lew's Dig., 181.

NINTH. The court erred in the admission of the evidence referred to in the 12th, 13th and 14th assignments of error.

TENTH. The judgment of the Circuit Court should be reversed, and a *venire de novo* ordered.

MATTHEW HALE,
Attorney, and of Counsel for Plaintiff in Error.

JAMES M. DUDLEY,
Of Counsel.

OPINION OF MR. JUSTICE HUNT.

CIRCUIT COURT U. S.—NORTHERN DISTRICT, N. Y.

NATHAN C. RUSSELL,
against
SAMUEL DODGE *et al.*
} *In Equity.*

HUNT, *Justice.*—This is a suit in equity, for an infringement of the complainant's patent for the treatment of bark-tanned leather.

The bill prays for an accounting for damages, and for an injunction.

The answer contains general denials, sets up want of novelty and other special matters.

The original letters patent bear date of August 17th, 1869.

This patent was surrendered and a reissue received, bearing date February 1st, 1870.

The first question I shall consider arises upon the construction of the patent. Does the patentee claim, as his discovery, the use of fat liquor to produce the effect he desires, or does he claim the use of heated fat liquor for that purpose?

The complainant insists that his patent is for the use of this liquor in its heated state. The defendants insist that the patent, by its terms, covers and includes the use of fat liquor generally, without reference to the condition in which it may be. The solution of this question is of vital importance, as the complainant now states and argues that the use of the liquor under his patent differs from the use thereof made by himself for twelve or fifteen years before obtaining his patent, and by Dodge for thirty years at intervals, and by various other persons named in the evidence, in the circumstance that the patent provides for the use of the liquor in its heated state as distinguished from liquor in its natural condition.

The entire description and specification in the reissued patent are as follows, viz.:

To all whom it may concern:

Be it known that I, Nathan C. Russell, of Gloversville, in the county of Fulton, and State of New York, have invented a new and useful improvement in the preparation of leather, and I do hereby declare that the following is a full, clear and exact description of the same.

My invention consists in a novel treatment of what is known as "bark-tanned lamb or sheep skin," an article used by bookbinders, and which, while sufficiently soft and supple for the purposes of their trade, is too hard and stiff for glove making, and a variety of other purposes. This objection is removed by my treatment of the article, and the latter rendered so soft and free, yet full in respect of body, as to adapt it, among other purposes or uses, to the making of what are termed "dog-skin gloves."

The principal feature of the invention consists in the employment of what is known amongst tanners and others as "fat liquor," which is ordinarily obtained by scouring deer skin after tanning in oil, but which, when it is not convenient to obtain in this manner, may be produced, or a liquor having the same character obtained, by the cutting of oil with a suitable alkali.

In treating leather with the "fat liquor" it is desirable to heat the latter to or near the boiling point, and it is preferred to use the same in connection with other ingredients; thus, for instance, there may be added to each ten gallons (10 gals.) of such heated fat liquor eight ounces (8 oz.) of sal soda, twelve ounces (12 oz.) of common salt, one pint (1 pt.) of soft soap, or an equivalent quantity of hard soap, and four ounces (4 oz.) of venetian red, such ingredients to be well stirred and mixed with the fat liquor.

This forms a good treating mixture or compound, and, when made in the foregoing quantity, will suffice for five or six dozen skins; but, of course, such quantity may be more or less varied, as may also the proportions of the ingredi-

ents, and the venetian red, or other coloring matter, be modified or omitted, as desired.

To effect the treatment, hereinbefore referred to, of the bark-tanned lamb or sheep skin, the same should be well dipped in or saturated with the fat liquor or compound of which fat liquor is the base. This may be done by laying the skin to be treated on a table or other suitable surface and rubbing the fat liquor or compound on or into both sides of the skin, using, for the purpose, a horse or other suitable brush or rubber, by which it can be worked into the skin, that is afterward hung out to dry, and subsequently "staked," when the character of said skin will be found entirely changed from harshness to softness, and other respects, thereby adapting it to the manufacture of gloves of the description previously named, and to a variety of other purposes for which said skin was not suitable prior to the treatment of it I have herein described.

What is here claimed and desired to be secured by letters patent, is:

1. The employment of fat liquor in the treatment of leather, substantially as specified.

2. The process, substantially as herein described, of treating bark-tanned lamb or sheep skin by means of a compound composed and applied essentially as specified.

N. C. RUSSELL.

Witnesses: FRED. HAYNES, FRED. TUSCH.

What is the conclusion to be drawn from this instrument?

After describing in general terms in what his invention consists, the patentee, at the close of his description, sums up by saying that he claims and desires to secure by his patent—

1. The employment of fat liquor in the treatment of the leather substantially as specified. No mention is here made of a necessity that the liquor should be heated.

2d. The process, substantially as herein described, of

treating bark-tanned lamb or sheep skins by means of a compound composed and applied essentially as specified. No mention is here made of heat in the general description. The compound referred to is incidentally mentioned as of "such heated fat liquor," with soda, salt, soap and venetian red, in the preparations stated. In the summing up, the heat is not declared to be essential, either in the use of the compound or of the fat liquor alone.

It is not insisted in the argument that the defendant has infringed the patent by the use of the compound, and no proof was given to that effect. Should it be supposed that heat was essential in the use of the compound, it would not therefore affect the present case.

It is only necessary now to ascertain the meaning of the first specification.

1. The invention is alleged to consist in a novel treatment of bark-tanned sheep skins, by which treatment they are rendered soft and free, and suitable to be manufactured into dog skin gloves. This is the result or effect, merely, and gives no light as to the process.

2. The "principal feature of the invention" consists in the employment of fat liquor, obtained from the scouring of deer skins, or manufactured by a process described. The employment of fat liquor, hot or cold, strong or weak, natural or manufactured, is the principal feature. So long as fat liquor in any condition is used, the principal feature is preserved.

3. In treating the leather with the fat liquor, it is "desirable" to heat the liquor, and it is "preferred" to use the same in connection with other ingredients, to wit, the soda, the salt and soap, as specified.

The words "desirable" and "preferred" are used to express the same idea, and each is used in contrast with essential or necessary; the meaning is this: "It is desirable to use the liquor heated, that is, the effect will be produced the more speedily, or with less trouble, or with less expense,

but it is not necessary to heat the liquor, and to use the liquor in connection with the other ingredients is the preferable way, but it is not the only way. You may still accomplish the purpose, by using the liquor without the other ingredients and without its being heated."

"This forms (the statement adds) a good treating mixture or compound." This again is an indication of a preference, but not of a necessity—a *good* treating mixture.

And again, "To effect the treatment * * the skin should be * * saturated with the fat liquor or compound of which fat liquor is the base." The fat liquor, without reference to its state or condition, or the compound, are here stated as the essential elements, and the same expressions are again used in describing the manner in which the liquor shall be applied. It is not required that the liquor shall be heated. After thus describing his process, the patentee sums up his claim under the two heads already stated. It is the settled rule in this country that the patent and the specification are to be construed together, and that the specification may control the general terms of the patent. (Curtis, § 221.) A reference to the specification gives the precise information required of the essentials of the patent, to wit:

1st. "The employment of fat liquor in the treatment of leather substantially as specified," making no distinction between its employment when cold or when heated; and 2d, the process of treating the skins by means of a compound composed essentially as specified.

If it should appear (as it does by the evidence) that the use of cold fat liquor produced a favorable effect upon bark-tanned skins, by softening them and rendering them fit for gloves, I am of the opinion that the patentee could, under this description, prevent its general use. Such use would be an infringement of his patent. In other words, the patent secures the exclusive use of fat liquor in any state or condition.

The reissued patent which I have thus far considered is, in this respect, quite different from the original patent of August, 1869. In describing his process, the patentee there says: "I take of fat liquor obtained in scouring deer skins, after tanning in oil, say ten gallons, and warm the same by heating it to or near the boiling point. I then add to such heated fat liquor eight ounces of sal soda, etc." And his claim is for "the process substantially as herein described, * * by means of a compound composed and applied essentially as specified."

In this description the heating of the fat liquor is not merely "desirable" or to be "preferred." It is an essential element of the process.

Every manufacturer would understand from the description that if he used the heated compound liquor he was within the prohibition of the first patent, while if he used cold liquor, or used liquor alone, the patent did not reach him.

But this specification the patentee amends by making his claim on the reissue reach the liquor itself, whether cold or hot, and making it reach the liquor whether employed as a compound or alone. He abandons his original claim, except so far as it is redescribed in the reissued patent.

In each particular, the difference between the patents is marked and striking.

I cannot resist the conclusion, that the reissued patent reserves to the patentee the exclusive use of fat liquor in the improvement of bark-tanned skins, whether the liquor shall be heated, or whether it is used without having been heated. In other words, any manufacturer using cold fat liquor in the improving of bark-tanned skins (prior use or want of novelty not being alleged) would be an infringer of the complainant's reissued patent.

The present is like the case of Booth v. Kennard (1 Hurst, p. 527).

It there appeared that, before the plaintiff's invention,

vegetable gas had been made from the oil expressed from seeds and other vegetable matter. The plaintiff discovered that such gas might be made direct from the seeds, omitting the intermediate process of pressing out the oil. In his specification he stated that the process might be carried on by the apparatus ordinarily used in making gas from coal, *but he preferred projecting the seed into a hot retort*, and gave a plan of a retort. He concluded, "I claim for making gas direct from seeds and matters herein named * * instead of making it from the oils, resins or gums, previously extracted from such substances." The main question involved was whether making gas from seeds, thus dispensing with the intermediate processes, was a patentable invention. On the second trial the patent was held void, for the reason that a previous patent had anticipated the discovery of the principle, that gas may be made direct from seeds, and on the ground that it was simply for doing a thing without pointing out any method of doing it. I cite the case only to show that the "preference" expressed of projecting the seeds into a hot retort does not appear to have been considered important. (Curtis on Pat., § 142.)

"Whoever (says Ch. J. Taney, in O'Reilly v. Morse, 15 How., 119) discovers that a certain useful result will be produced in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for it, provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without addition to or subtraction from them, produce precisely the result he describes. If this cannot be done by the means he describes, the patent is void, and if it can be done, the patent confers on him the exclusive right to use the means he specifies, to produce the result he describes, and nothing more." It would seem too plain for argument that the means thus described are the essential and absolutely

necessary means, and not mere adjuncts which may be used or abandoned at pleasure.

In Stevens v. Keating (2 Web. Pat. Cases, 172 Curtis, § 258), the patentee in his description said, "dissolve one pound of strong alkali (for instance, American potash) in one gallon of water; this solution is to be neutralized with *acid* (sulphuric is the *best* for the purpose)." On the trial it was proved that a well-known acid, nitric, would not answer, and the specification was held insufficient. A preference was here expressed for sulphuric acid, but it was held by necessary implication that this did not make that acid a required means of accomplishing the result, but that all well-known acids were included in the general terms used.

The authorities show that the words "desirable" and "preferred" are not essential parts of the description of the article patented. The patentee may have intended to take a patent for use of heated fat liquor, but he has failed to express it in his description and specification.

Assuming the patent to cover the use of fat liquor generally for the purposes indicated, can it be sustained? The objection of want of novelty is interposed, and in support of it numerous witnesses have been examined.

The evidence is furnished by many witnesses, that the use of fat liquor in treating bark-tanned skins had been general among manufacturers for many years, prior to the plaintiff's alleged invention.

James Christie testifies that, for the last twenty-five years, he has used fat liquor in the manufacture of leather for gloves and mittens, and that he thus used it on all kind of skins, deer skins, sheep skins, lamb skins, dog skins, calf skins and goat skins; that it was thus used to soften the skins, and that it had that effect.

It was used by him apparently, not as a general process, but when the skins had been scoured to clean, or had too much alkali in them or were not properly milled, and it

was chiefly applied to oil-dressed skins. He says, "sometimes we find, after they are scoured and dried, there is too much alkali in them, and sometimes we think they are over scoured, are after rained on, which flattens the leather; * * where there is too much alkali in it, it leaves the skins hard and light. In that case, we use fat liquor, which makes it more soft and pliable. When over scoured it leaves them hard and light, and fat liquor renders them soft and pliable."

Jonathan Ricketts testifies, as early as the year 1851 he applied fat liquor to the improvement of bark-tanned skins. He says: "My first lot was 1,900 sheep skins. I got them in the bark-tanned state ready for bookbinding. They were not suitable for mittens or gloves; they were squeaky, bad-colored and dirty; neither hard or soft medium. I got Samuel Dodge, senior, to wash them over, through fat liquor, eggs and soap. * * The application of this fat liquor to the skins made them soft, took out the squeak, made them cleaner and better color. They were made up into gloves." The same process was applied to another lot of 200 dozen procured from Brand, of New York. He says again: "In my business I used fat liquor for twenty-five years for the purpose of softening the skins."

John Filmor testifies that, in 1852, Mr. Dodge treated bark-tanned sheep skins by fat liquor—about 400 dozen. He says it was ordinary skin mill fat liquor. They were put into the warm fat liquor, stirred up, trod upon and rendered more soft and pliable. Nothing except fat liquor was used, so far as he knew.

Aaron Simmons testified that, for twelve or fifteen years, he has used fat liquor alone in dressing skins, using the liquor both warm and cold. He says he has treated Indian-tanned deer skins with fat liquor for fifteen to eighteen years, and about 1,000 skins per year. They were thus treated to make them soft, and were cut up into gloves and mittens.

Isaac V. Place testifies that the use of fat liquor in softening glove leather has been known and practiced by him for thirty-nine years. He is not able to state definitely the year in which fat liquor was used in the treatment of bark-tanned skins until the year 1856. In that year he thus treated the bark-tanned skins to the number of 140 dozen or more. The effect was to soften the leather, and it was made up into mittens and gloves. In 1857 200 dozen were again so treated by him, and in 1858 perhaps twenty-five dozen. The practice was followed, he says, for every year, but he can't again fix it positively until 1862, and since that time it has been done every year. He testifies also that this treatment has been generally known and used in Gloversville for twenty-five years past.

Samuel Dodge, the defendant, testifies that he treated bark-tanned skins with fat liquor alone in 1852 and 1853, for the Churchills in Gloversville, and again for Spalding almost the same time, and again for Gilchrist about the same time; also for Chapman & Varing about fifteen years ago, and for Judson about the same time; also for Heacocks about fourteen years ago, and for Mr. Nichborn about thirteen years ago. He also told Chapman how to treat skins by this process, and gave Mr. Russell the same information.

He performed the same operation for Mr. Judson four or five years before the trial, about one hundred dozen. Again he applied it about two years ago, and he says that every week since that time he has treated about forty dozen bark-tanned skins with fat liquor.

During all this period he varied the treatment of the skins according to their condition. Those that were especially hard, heavy and bark-bound, he treated with fat liquor, compounded with ammonia, oil and eggs; the others with fat liquor alone. Of the skins, three-fourths generally were treated with fat liquor alone, and one-fourth with the compound mentioned.

James Northrup in like manner testified that he had used fat liquor in the treatment of bark-tanned skins, commencing in 1854; that he sometimes used the liquor alone, and sometimes in connection with other substances. Before the liquor was applied, these skins were hard and squeaky and stiff. The treatment removed the squeak, made them soft, fit for use for gloves and mittens. In 1854 and 1855 he thus treated about fifty dozen. In 1856 and 1857 he thinks 200 dozen, and again in 1862 a quantity were thus treated. He states that he did not continue the manufacture after 1857, for the reason that he could buy imported skins cheaper than he could then manufacture them.

Mr. Heacock, Mr. Munroe, Mr. Hull, Mr. Case, Mr. James F. Place and Mr. Philiman, testify to the same purport. It is worth while we consider their testimony in detail.

To this evidence, and especially to its effort, the complainant makes objection, and in the particulars following:

1st. He says that this evidence is applicable to the use of fat liquor upon oil and Indian-dressed skins, and in such cases it is applied really to tan the raw article, while complainant's process is to be applied to skins already tanned.

It is not necessary to inquire whether this answer would be a good one, if wholly true, or whether the patent would not, in that case, be void, as being simply for a new use, or application of an old invention. It is true, in the present case, that in many instances the liquor was thus applied. It is true, also, that every witness speaks of it as being applied to bark-tanned leather also, and that it had been thus applied, and extensively, before the issuing of the patent to the complainant.

2d. It is said that the application was made, to skins imperfectly tanned, and to remedy such defects. This is true in part, but does not embrace the whole case. It was applied, also, largely to soften and improve the skins already sufficiently tanned.

3d. It is said that the skins thus treated by the defendant

and his witnesses have in them what is called "squeak," an objectional quality in leather used for gloves, while one of the objects and benefits of the Russell process is to remove this "squeak." The answer to this suggestion is twofold.

1st. It may well be that the defendants have not performed the process as well and skillfully, and have not produced as good leather as does the complainant. It may be that his process of dipping the leather for ten or fifteen minutes is better than the defendant's plan of treading the skins, or of keeping them in the liquor for one or two days. This, however, is merely a difference in the manner of applying the invention, and is quite immaterial.

2d. There is nothing in the patent, or in the specification, on the subject of "squeak." The word is not found there. The discovery is set forth, and its object is given as the softening of leather. This discovery, it is proved, had been used, and this effect produced long prior to the complainant's patent, and whether the squeak was removed, I cannot believe to be an essential point.

4th. It is said that the fat liquid thus applied was always used in a cold state, and was not therefore an infringement of the complainant's patent. If I have correctly construed the complainant's reissued patent, it prohibits to others the use of fat liquor when applied to bark-tanned skins, whether such liquor be cold or hot. This objection goes to the main question of construction, upon which I have already given my opinion.

5th. The evidence of the witnesses is criticized at great length; that of Dodge Senior, in twenty-five specifications, and that of the other witnesses in like manner, but in less degree. Rebutting or contradicting witnesses, chiefly of a negative character, were called by the complainant. After listening to the full discussion of this point, and now carefully reflecting upon it, I content myself with saying that I think the use of fat liquor in the treatment of bark-tanned leather is

proved to have been known and practiced prior to 1869 and 1870, and quite extensively.

6th. It is said that fat liquor is now used almost universally by the glove manufacturers, either under the patent or in defiance of it, and that this greater use now is evidence that the knowledge of it was derived from the patent.

This may be true or it may not; the great increase in the manufacture may, in part, explain it. It may be, too, that while its use was known and practiced quite extensively, that there were yet large numbers who did not know it. New persons may have come on to the stage, and its being patented has undoubtedly called greater attention to it than before existed. Its benefits are now universally known. All desire to use it. This, however, does not prove that it was not known to many and extensively used by them before the issuing of the patent.

7th. It is said that the instances proved by the witnesses, in which the liquor was used, were experimental merely. Use of this character does not violate a patent, and if the parties named as using the fat liquor were treating the skins by way of experiment to ascertain what would be the result in each case, and not by way of using or taking the benefit of a known and established process, then it is not a prior use which avoids a patent. I think, however, that no one can read the testimony of Mr. Dodge, Sr., and doubt that he used the process with an intelligent comprehension of its effect. He used it repeatedly in treating the skins of other persons brought to him to be prepared, as one skilled in the art. He used the process year after year in his business regularly. He applied the fat liquor simply to the skins of a character that would be softened by its use alone, and when so hard and stiff that the liquor alone would not accomplish the purpose, he added certain other ingredients still more powerful. This repeated action, always of the same character, always intended to produce a particular result, and always followed by that result, cannot be termed experi-

mental. The testimony of the witnesses shows that when used, it was known and understood that the result would follow, and that the skins were thus treated, not by way of experiment, but in the regular business of preparing the skins for the manufacture of gloves.

Kindred to the question discussed thus far is the objection made by the defendants under the 5th subdivision of section 61, of the patent law of 1870. This clause avoids a patent when it is proved that it has been in public use or on sale in this country for more than two years before the application for a patent, or has been abandoned to the public. It is alleged that the complainant had so used his invention for more than two years before applying for his patent, that he had abandoned his right to the public, and cannot recover in this action.

The evidence upon this point is less satisfactory than upon the one just disposed of, but I think this defense is also reasonably made out. Thus it is proved by Dodge that eight or nine years before the trial the plaintiff brought to him a quantity of skins to be dressed, which he was not able to attend to, but told the plaintiff how to treat them with fat liquor, and promised to color them when they had been thus treated by him. In a few days the plaintiff brought back the skins to be colored apparently thus dressed, and by himself. If the plaintiff had denied this statement or denied that he had thus dressed them, the case would have been weak, but uncontradicted, it is fairly to be taken that the complainant then dressed his skins with this liquor. So when another witness testifies that, prior to the war of 1861, he examined the skins of the complainant's dressing on several other occasions, smelling of them and squeezing them, and that he judged from this examination that they had been dressed with fat liquor, and that he could determine the fact by such examination; and the plaintiff, although present at the examination, does not contradict, and does not state that they were dressed by some other

process, it is a fair deduction that the conclusion of the witness was a just one.

So when another witness testifies that he has seen the fences near the complainant's premises filled with skins treated with fat liquor, for several successive years before the war, and the complainant declines to state whether they were or were not so treated, or whether they were treated with any compound, he can hardly object if a conclusion is drawn that they were treated with fat liquor, and with that only. In any or all of these instances, if the skins were treated by the complainant, not in the course of his ordinary business, as would be the presumption, but as experiments upon the process, and in endeavors to effect a new result, he should so state as a witness. He does not, and we may justly conclude that he could not.

As matter of fact, if this treatment of skins was of the complainant's discovery, and was thus used by him, I think he has so used it that he is to be deemed to have abandoned it to the public, and that he cannot now maintain a patent for such discovery.

The question of the validity of the reissued patent is much pressed. The defendants insist that it is not for a discovery or invention which is indicated by any part of the original specification, that it is not therefore a correction or alteration of the original patent, but that it is for an original invention. As the points already discussed by them must lead to a decision adverse to the complainant, it is not necessary that I should pass upon this point. If the case is taken to a higher tribunal for reconsideration, this with other points will necessarily be passed upon.

A decree must be made dismissing the complainant's bill, with costs.

WARD HUNT.

UNITED STATES OF AMERICA,
CIRCUIT COURT CLERK'S OFFICE,
NORTHERN DISTRICT OF NEW YORK. } *ss.:*

I, Charles Mason, clerk of said court, do hereby certify that I have compared the foregoing copy of opinion of Hunt, J., and indorsements thereupon, with the original now on file in this office, and that the same is a correct transcript therefrom, and of the whole of said original.

In testimony whereof, I have caused the seal of the
[L. S.] said court to be affixed at the city of Utica, in said district, this 28th day of August, A. D. 1873.

CHARLES MASON, *Clerk.*

IN THE

SUPREME COURT

OF THE

UNITED STATES.

No. 181.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES
FOR THE NORTHERN DISTRICT OF NEW YORK.

ALBERT KLEIN, Plaintiff in Error,

vs.

NATHAN C. RUSSELL.

BRIEF OF DEFENDANT IN ERROR.

HORACE E. SMITH,
of Counsel for Defendant in Error.

ALBANY, N. Y.:
J. MUNSELL, LAW PRINTER.
1874.

SUPREME COURT

OF THE

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No. 181.

IN ERROR

TO THE CIRCUIT COURT OF THE UNITED STATES
for the Northern District of New York.

ALBERT KLEIN, *Plaintiff in Error,*
against
NATHAN C. RUSSELL.

BRIEF OF DEFENDANT IN ERROR.

STATEMENT.

The invention in this case consists in a process for preparing bark tanned sheep and lamb skins for gloves, by the agency, mainly, of "fat liquor," an article produced by the scouring of deer skins after tanning in oil. Bark tanned leather, before this treatment, is harsh, squeaky, and unsuitable for gloves; but the patented process removes the "squeak," renders the leather soft and pliable, and suitable for a fine glove.

This treatment, costing only from twelve to twenty-five cents per dozen skins, enhances their value, at least two dollars per dozen, and furnishes a cheaper material for gloves than any other in the market, of the same quality and value.

For many years prior to this invention, there had been a scarcity of suitable materials for gloves; and,

although the bark tanned sheep and lamb skins were plenty and cheap, they were used for that purpose to a very limited extent only, and for a coarse and cheap article, only. But on the publication of Russell's patent, this leather immediately came into general use, and the business was, to a large extent, revolutionized.

The patentee claims, and has patented two things: 1. A novel treatment of bark tanned sheep or lamb skins, by heated fat liquor, substantially as described in the specification; and 2. The treatment of such skins with a heated compound, composed and applied substantially as specified.

The infringement in the case at bar consisted in the use of the compound.

POINTS.

FIRST.

The first alleged error assigned, consists in permitting the question to the witness Uriel Case, "Did Mr. Russell come and forbid you going on? (Printed Record, p. 18).

1. This question was proper, and the answer admissible.

   The witness had testified to the treatment of skins eighteen or twenty years ago, in a manner claimed by defendant to be substantially like the patented process.

   That he did not try it again until last year, after the issue of the patent in question, and it was at this time that the interview occurred between witness and the patentee, to which the question pointed.

2. The question was proper as introductory to witness's statements at said interview, and proof of the fact elicited by his further cross-examination, that when charged with an infringement of the patent, he made no pretense of prior knowledge, but claimed that he "had a way of his own," etc.," or, in other words, that he did not then infringe.

   If he did not *then* treat skins according to the patented process, it was a reasonable inference that he did not prior to the patent, for he claimed that his method in both cases was substantially the same.

3. The question was proper for the purpose of showing witness's feeling towards the plaintiff below, and his patent.

SECOND.

Secondly, it is alleged as error, that John W. Place, a witness for defendant below, was permitted on cross-examination to give the contents of a certain subscription paper in relation to the expenses of this suit, and the defense of the manufacturing interests against Russell's patent. (Record, pp. 18 and 19).

1. The object of this evidence was, obviously, to show a combination among defendants' witnesses, including the witness under examination, to defeat the patent and share the expense, thus affecting their credibility.

   The propriety of allowing the plaintiff below to prove such a combination, if he could, is beyond question.

   Woodworth v. Sherman, 3 Story, 171, 172.
   Evans v. Eaton, 7 Wheat., 356, 425.

2. The objection that it was not the best evidence, is untenable.

It was upon a collateral matter arising incidentally in the progress of the trial, affecting merely the credit of the witness, and is an exception to the rule invoked to sustain the objection.

3. The plaintiff below was entitled to the evidence sought, without taking any steps to lay the foundation for it.

   (*a*). To whom should a notice to produce be given?

   There was no presumption that the defendant below had possession of it.

   (*b*). Plaintiff could not know in advance who would be called by defendant to testify; and it would be unreasonable to require him to subpœna hundreds of manufacturers in the community, all of whom were interested to break down the patent, and none of whom, in particular, could be presumed to have possession of the paper.

4. The question elicited no material evidence, and hence error cannot be predicated upon its admission.

   The witness did not know who signed the paper, and the evidence complained of is, therefore, harmless.

Philadelphia, Wilmington and Baltimore R.R. Co. v. Howard, 13 How., 307, 334.
Greenleaf v. Birth, 5 Pet., 132, 135.

THIRD.

The plaintiff in error complains of the question to Dr. Porter, the expert. "Will you state whether the effect of the fat liquor applied to oil tanned and bark tanned skins is the same or different?"

This question was objected to "as immaterial, the purpose for which the process is used being immaterial, if the process is the same." (Record, p. 21).

1. This question, it is insisted, was material and proper.

The defendant below had given evidence of the use of fat liquor upon oil tanned skins for many years prior to plaintiff's patent, which use, he claimed, was the same, substantially, as the patented process.

(See testimony of Harmon Krouse, pp. 14 and 15, of the Record; Samuel Dodge, p. 15; and Niles Fairbanks, at p. 17).

The oil tanned skins referred to by these witnesses, were skins dressed from the raw in oil, and the fat liquor used upon them was a part of, or in aid of, the oil dressing process.

(See evidence of Fairbanks at p. 17, and James Brownell, at p. 23).

The plaintiff below claimed that the use of the fat liquor in the process of oil tanning, is essentially different from the patented process. That in oil dressing, and Indian dressing, as it is termed, the fat liquor is used in connection with oil for the purpose of *tanning* the pelt, or, in other words, of *converting it into leather from the raw state;* while in the patented process the fat liquor is applied to a skin *already tanned*, and for the purpose of softening and adding new properties to it.

In this state of the case, the question objected to was manifestly proper.

2. While it is true that the mere purpose, or effect of a machine or process is not patentable, it is equally true that the effect or result produced is always proper to be considered when a patent is on trial, and often very material in determining the questions of utility and novelty.

Curtis on Patents (2 Ed.), §§ 8, 9, 10, 14, 18.
Fairbanks vs. Cook, 2 Fisher, 668, 672.
Hall vs. Wiles, 2 Blatchf., 194, 200.
Eames vs. Cook, 2 Fisher, 146, 149.
Judson vs. Cope, 1 Fisher, 615, 624.
Crane vs. Price, 5 Scott, N. S., 338, 388.

(*a*). In *Hall* vs. *Wiles*, cited *supra*, Nelson, J., at p. 200, says: "And in determining this question"— the patentability — "the jury have a right to take into consideration, in connection with the change, the *result which has been produced.* Because the result, if greatly more beneficial than it was with the old contrivance, *reflects back*, and tends to characterize, in some degree, the importance of the change."

3. The admission of this question was not in conflict with the rule applicable in case of "double use."

It was a proper and legitimate mode of solving the question raised by defendant's evidence, whether the patented process was or was not the application of an old principle or process to a new and analagous use.

4. Even if this question were improper, the answer, if not in itself harmless to the plaintiff in error, became so under the charge of the court.

On this point he charged, "that the application of an old invention or an old machine to produce a new result, because it is applied to different material, is not an invention, and the question of novelty is to be determined in the same way. That under the first claim of the plaintiffs, if this particular process was used for the purpose of softening leather, it is not material that it was bark tanned sheep or lamb skins, if it be used as a process for that purpose." (Record, p. 27, under the 7th request of defendant.)

FOURTH.

The fourth alleged error is the refusal of the court to direct a verdict for the defendant.

1. The court could not properly give the direction prayed, as there were questions of fact for the jury; upon which, or some of them, there was a conflict of evidence.

   (*a*). On the question of prior use, the defendant below examined as witnesses, among others, William H. Monroe (p. 12); Harman Krouse (p. 14); Samuel Dodge (p. 15); Henry Hull (p. 16); Niles Fairbanks (p. 17); Uriel Case (p. 17); Adam Quackenbush and John W. Place (p. 18).

   (*b*). The plaintiff below insisted that, from the cross examination of these witnesses, it was apparent that none of them ever used his process, or had an intelligent idea of it prior to the patent.

   Monroe, on cross-examination (pp. 13 and 14), shows clearly that he had no intelligent idea of plaintiff's process prior to the patent; that he experimented in various ways, but never achieved the desired result.

   Krouse, on cross-examination, in relation to his alleged use and knowledge of the process (p. 14), testified that "whether they warmed the fat liquor depended upon the weather and the time they wanted to spend," thus showing that he had no intelligent idea of a defined process, such as the plaintiff patented.

In relation to the effect produced by his treatment he said that "they" — the skins — "were made soft enough to do for glove manufacturing, as they thought, so that they *would not break out the stitches*"; thus showing that his treatment was very imperfect, and the product much inferior to plaintiff's leather, which was very soft and pliable, and suitable for gloves of all kinds from the finest to the heaviest. (See plaintiff's testimony on this point, pp. 10, 11, and 12).

The same, in substance, is true of all the evidence of the defendant below, on the question of prior use.

(*c*). The plaintiff below examined as witnesses, among others, on this question, John Fulton (pp. 10 and 12); William W. Whittaker (pp. 11 and 12); Arthur Gulick (p. 22); James Brownell (p. 23); Daniel S. Hewlett (p. 23), and Theodore Welch (p. 23).

These were all more or less, and some of them quite familiar with the glove business in the vicinity, and during the whole period covered by the alleged prior knowledge of defendant's witnesses; and they all testify, in substance, that they had no knowledge of such leather as plaintiff's till about the date of his patent.

On the question of prior use, evidence of this character is justly held to possess great significance and value.

Curtis on Patents (2 Ed.), §§ 359, 360.

(*d*). It also appeared that, upon the publication of plaintiff's patent, the kind of leather produced by him went into extensive use, and there

was a great demand for it in the market. (Evidence of Fulton, p. 10).

(*e*). The evidence of Cornelius A. King and Arthur Gulick, witnesses for plaintiff below, tends directly and strongly to impeach the testimony of defendant's witnesses, Dodge and Hull.

2. Where there is any evidence to be weighed by the jury, and where, in any possible construction of the testimony, it would support the action, a verdict for defendant cannot be directed.

Bank of Washington v. Triplett, 1 Pet., 25, 31.
Schuchart v. Remington, 1 Wall., 359, 371.
Barney v. Schneider, 7 Wall., 248, 253.

FIFTH.

The fifth error assigned was the refusal of the court to charge the jury, when requested, "that the invention claimed by the plaintiff below, as described in the patent of February, 1870, was the treatment of bark-tanned sheep and lamb skins by the employment of fat liquor, and if the jury believed that such treatment was known to others, and more than two years before the plaintiff below applied for his patent, his patent was void, and the defendant below entitled to a verdict." (Record, p. 26).

1. The request does not correctly or fully describe the invention, and it would have been erroneous to charge as requested.

   The employment of fat liquor, merely, is not the whole of the invention. It is the employment of fat liquor in the *condition* and *manner* described in the specification.

2. The request erroneously assumes that a knowledge by others of the thing patented, more than two years before *application for the patent*, renders it void.

The first discoverer or inventor, under our law, is entitled to a patent, provided he uses "reasonable diligence in adapting and perfecting" his invention; and in perfecting it, he is not limited to two years.

Suppose an inventor to be ten years in perfecting his invention; and more than two years prior to his application for a patent, some other party steals his secret, and "surreptitiously or unjustly" obtains a patent for it; the inventor would be, nevertheless, entitled to a patent; and the prior knowledge of the other party would not invalidate it.

3. If a prayer for instruction be not correct *in its very terms*, it is not error to refuse it.

Brooks v. Marbury, 11 Wheat., 78, 94.
Elliott v. Peirsol, 1 Pet., 328, 338.
United States v Bank of the Metropolis, 15 Pet., 377, 406.
Catts v. Phalen, 2 How., 376, 382.

4. The charge to the jury covered the ground of this request, and embraced all the defendant below had a right to ask upon the point involved.

The following instructions, among others, were given to the jury: "That taking the re-issued patent as the basis of the plaintiff's claim, the true construction of the first claim is the employment of fat liquor generally, in the state in which it comes from the mills, in the treatment of leather substantially as described.

"That the first claim covered the employment of fat liquor in its pure and simple state.

"That the second claim covered the compound substantially as described in the specification, and

that the heating of the liquor was an essential portion of the patented process under this claim." (Record, p. 24).

"That upon the question of the validity of the patent, they" the jury "were to look to the proof in regard to the use of fat liquor, substantially in the manner described when fat liquor alone is used, unconnected with the other ingredients constituting the compound, which is covered by the second claim in the patent; that, if the jury should find that this process had been used prior to plaintiff's alleged invention by other persons, as stated and claimed here, that the persons who used the process were aware of the object and character of it, observed and comprehended the beneficial results produced by its use, then the patent would be void upon the ground of want of novelty, although some circumstances might have induced them to abandon, temporarily, the actual practice of the invention, or the use of the process." (p. 25).

"That if they came to the conclusion that the process claimed in the first specification, that is, the fat liquor had been so used substantially as described in the specification before this invention, that was the end of the case" (p. 25).

(*a*). The court is not bound to repeat to the jury the same substantial proposition of law, in different forms; it is enough that it be once laid down in an intelligible and unexceptionable manner.

Kelly v. Jackson, 6 Pet., 622, 628.
Mills v. Smith, 8 Wall., 33.

(*b*). It is not error to refuse to give instructions asked for, even if correct in point of law, provided those given cover the entire case, and submit it properly to the jury.

Laber v. Cooper, 7 Wall., 565, 571.
Mills v. Smith, 8 Wall., 27, 33.

(*c*). Nor is the court bound to instruct the jury in the terms required by either party; it is enough that so much thereof is given, as is applicable to the evidence and the merits of the case.

Clymer v. Dawkins, 3 How., 674, 688.
Pitt v. Whitman, 2 Story, 609, 620.

SIXTH.

The sixth assignment of error is the refusal of the court "to rule and charge the jury when thereto requested, that the proper construction of the patent was that the fat liquor should be applied at or near the boiling point, and that if the jury believed that the application of the fat liquor at such a temperature to leather was injurious and pernicious, the patent was void for want of utility, and the defendant below entitled to a verdict; — and also in modifying said request, and charging the jury that the proper construction of the second claim of the patent, so far as related to the application of heat, was that the compound should be applied at or near the boiling point, unless the common knowledge of persons skilled in the art of treating leather should make them wait until it was partially cooled before its application." (Record. p. 26).

1. The court properly refused to charge as requested, and the modification was correct.

The court had already charged on this point as follows: "That specifications are not addressed to men entirely ignorant of the manufacture to which the specification relates, but to persons skilled in the art to which it appertains; that if, upon reading the specification, parties skilled in the art of dressing skins would know that this heating was for the purpose of making this compound with the fat liquor or for some other pur-

pose, and that it would not do to apply the fat liquor at or near the boiling point, because it would destroy the leather, such parties would not be misled by it, and therefore it would not be a fatal defect; but that, if persons skilled in the art, in attempting to put the plaintiff's invention in practice under the specification, would ordinarily apply the liquor to the skins used while it was at or near the boiling point, and thus destroy them, then of course, this specification was bad." (Record, p. 24).

(*a*). This charge, and the modification of the request under consideration, correctly present the law applicable, and were sufficiently favorable to the defendant below.

Act of 1836, Chap. 357, sec. 6.
(5 Stat. at Large, p. 117).
Curtis on Patents, (2 Ed.), §§ 153-4-5.

2. Whether the specification is sufficient, within this rule of law, is a question of fact for the jury; and in the case at bar it was properly submitted to the jury.

Judson v. Moore, 1 Fisher, 544, 547.
Davis v. Palmer, 2 Brock, 278, 308.
Wood v. Underhill, 5 How., 1, 4.
Battin v. Taggert, 17 How., 74, 85.

SEVENTH.

The seventh alleged error assigned is, the refusal of the court to charge "that if the patent did not intend that the fat liquor be applied to the leather, when at or near the boiling point, it was, in respect to the application of heat, void for ambiguity." (Record, p. 26).

1. This refusal was correct, and for the reasons given under the last point, and also on grounds stated under the tenth point.

(*a*). The court assigned as reasons for not charging as requested on this point, those "substantially appearing in the modification of the last preceding request."

EIGHTH.

This alleged error, is the refusal of the court to charge, "that if they believed that cooling the fat liquor after boiling was an essential point of plaintiff's process, then the patent was void for not indicating that such process was necessary, or how it was to be accomplished; and also in modifying such request by adding the words as to the common knowledge of persons skilled in the art of treating leather" (Record, pp. 26 and 7).

1. The modification made by the court consisted in adding thereto the words, "unless the common knowledge of persons skilled in the art of treating this leather to produce softness and pliability would make the operator wait until it was partially cooled before its application;" and the jury were instructed pursuant to the request thus modified.

   It would have been erroneous to charge as requested, without the modification.

   The question here involved is substantially the same as that present in the last two points.

   It is sufficiently discussed there, and hereinafter under point Ten.

NINTH.

The ninth alleged error consists in the refusal of the court to charge," that the addition to the fat liquor of the other ingredients mentioned in the specification

was not patentable, if such addition does not change the properties of the fat liquor, or its effect or usefulness when applied to the purposes mentioned in the patent or specification; and also in modifying such request by adding thereto the words, "or to other like purposes," and in charging the request as so modified" (Record, p. 27).

1. The charge was in accordance with the request except in the addition of the words, "or to other like purposes."

   If the request without this addition was proper as far as it went, the addition was proper, unless the *mere purpose* or *application* of a contrivance or process is patentable, which will not be claimed.

   If the addition was *right*, the request without it was *wrong*.

2. The court had already charged the jury, in substance, that utility is requisite to the validity of a patent. He "charged that the person who first invented a new and *useful* machine, or improvement in a machine, or any new and *useful* process to be used in the arts or in manufactures, is entitled, on complying with the provision of the act of Congress, to obtain letters patent therefor." (Record p. 24.)

   The converse of the proposition is, that an invention *not useful* is *not patentable*.

3. The patent was *prima facie* evidence of utility, and there was no conflicting evidence on this point.

   Hence, the request involves only an abstract question, and error cannot be predicated of the refusal to instruct.

Rhet vs. Poe, 2 How., 457, 483.
Chirac vs. Reinecker, 2 Pet., 613, 625.
Clark vs. Hownslar, 10 Pet., 657, 660.
Tucker vs. Moreland, 10 Pet., 58, 78.

TENTH.

Alleged error in the refusal of the court to charge "that the process of preparing leather by means of a compound as claimed by the plaintiff below, was not patentable, because the proportions of such compound were not fixed, but were in all respects indefinite and uncertain, and might be waived or omitted by the terms of the patent" (Record, p. 27).

1. In charging the jury, the court had already construed the patent as embracing two claims; 1. The employment of fat liquor in its pure state as it comes from the mills, in the treatment of leather substantially as described; and, 2, the compound substantially as described in the specification. (Record, p. 24).

   To this construction the defendant below did not object, and he cannot now question its correctness.

2. The compound, then, being claimed and patented, the request and exception under consideration present one question, only: Is this claim void for uncertainty, because the specification does not prescribe exact and unvarying proportions in the ingredients of the compound?

   (*a*). The formula given in the specification is. "To every ten gallons (10 gals.) of the heated fat liquor, eight ounces (8 oz.) of sal. soda, twelve ounces (12 oz.) common salt, one pint (1 pt.) of soft soap, or an equivalent quantity of hard soap, and four ounces (4 oz.) of Venetian red." (Record, p. 9).

   This gives fixed and certain proportions in the compound, as a general rule.

(*b*). But. the specification goes on to say that the proportions of the ingredients may be more or less varied, and the Venetian red or other coloring matter be modified or omitted, as desired.

It evidently does not mean, as plaintiff in error seems to suppose, that all the ingredients may be omitted; for this part of the specification is treating of the *compound*, and if all the ingredients were omitted it would, of course, be no compound, but fat liquor, simply.

The other ingredients may be varied, but the Venetian red, or other ingredients may be omitted, if desired.

A variety of colors are required in glove leather, and the use or omission of the coloring matter, as well as the kind to be used, would, it is obvious, depend upon the color of the leather desired in a particular case; hence, the impracticability of prescribing in the patent any exact and invariable rule for its use.

(*c*). If the patent fixed the exact and invariable proportions of the other ingredients, it would enable the community to produce the same results, and use the invention with impunity by a slight variation of the proportions, not affecting essentially the character of the compound.

This treating mixture does not profess to be a composition united by the laws of affinity and definite proportions, but a compound of different ingredients for a practical purpose, which, from the nature of the case, might sometimes require slight departures from the exact formula.

(*d*). In this, as in other respects, the specification is addressed to persons "skilled in the art or science to which the invention appertains," and something must be left to their judgment and discretion in the use of the process.

3. It has been held by this court and other good authority, in similar cases, that where the patentee gives a certain proportion as a general rule, which on the face of the specification seems generally applicable, the patent will be valid, though some small differences may be occasionally required.

(*a*). It was so held in *Wood* v. *Underhill* (5 How., 1), in a patent "for an improvement in making brick, tile and other clay ware."

In this case, there was more uncertainty in the ingredients of the composition than in the one at bar. The specification stated that the exact proportions of the ingredients could not be given; yet the patent was held good.

(*b*). To the same effect is Ryan v. Goodwin, (3 Sum., 514).

This patent was for an "improvement in the manufacture of friction matches." The specification, after giving the composition used in preparing the matches, says: "The composition may be varied in its proportions, but those I have given I consider the best. The ingredients also may be varied; as gum arabic or other gum may be substituted for glue, and other absorbent earths or materials may be used instead of the carbonate of lime."

It was objected to this specification that its terms were too vague and indefinite, and the

claim too broad to support the patent. But the court—Story, J.—held otherwise, and the jury returned a verdict for the plaintff.

4. The rule of construction upon this, and all other points is, that patents are to be construed liberally in favor of the patentee; so construed, if possible, as to give the patentee the benefit of what he has actually invented.

Ryan v. Goodwin, 3 Sum., 514, 520.
Ames v. Howard, 1 Sum., 482, 485.
Corning v. Burden, 15 How., 252, 269, 270.
Whitney v. Emmett, Bald., 303, 315.
Goodyear v. Railroads, 2 Wall. Jr., 356, 363.
Judson v. Moore, 1 Fisher, 544, 550.
Davoll v. Brown, 1 Wood & Min., 53, 57.

(*a*). In Ryan v. Goodwin, cited *supra*, Story, J., at p. 520 says: "It is a clear rule of our law in favor of inventors, and to carry into effect the obvious object of the constitution and laws, to give a liberal construction to the language of all patents and specifications, *ut res magis valebat quam pereat*, so as to protect, and not destroy, the rights of real inventors."

ELEVENTH.

This alleged error is, the refusal of the court to charge, "that if the jury should find from the evidence that fat liquor had been used substantially in the manner specified in the plaintiff's patent for the purpose of rendering any kind of leather soft and supple more than two years before the plaintiff below applied for a patent, the plaintiff below could not recover, even though it had not been so used in dressing bark tanned lamb or sheep skins." (Record, p. 27).

1. This request referred to a prior use more than two years before *plaintiff's application for a patent*, and the court properly refused so to charge.

Defendant's counsel then modified his request, by substituting "*before the plaintiff's invention*," for "*before the plaintiff applied for a patent*;" and the court thereupon charged substantially as requested.

2. The charge already given, sufficiently and correctly covered the ground involved in this request, and the court was not bound to repeat it, even had the request been right in point of law. (Record, p. 25.)

See, also, point Five, above.

TWELFTH.

It is complained that the court refused to charge when requested, "that if the jury believed that the object of plaintiff's process was to substitute a less valuable article for that commonly known as "dog skin," and to impose upon the public by representing gloves made of softened sheep and lamb skins as dog-skin gloves, the patent was void for fraud, and the plaintiff below could not recover." (Record, p. 27).

1. This request was purely abstract and speculative, involving a question not presented by the evidence.

The court was not bound to notice it at all.

See authorities under point Nine.

2. The court did charge, however, in response to this request, "that if the process patented could not be made useful for any honest purpose, but only for perpetrating a fraud upon the public, and was not useful, but pernicious, the plaintiff could not recover."

This was more than the defendant below was entitled to demand, and so far as he is concerned, is unexceptionable.

THIRTEENTH.

This alleged error consists in the refusal of the court to charge that, if anything claimed by the plaintiff below in this patent as new, was in fact old, the entire patent was void and plaintiff could not re-recover." (Record, p. 28).

1. The record shows that the "judge declined so to charge, except as had already been charged in the portion of the charge hereinbefore set forth."

   By reference to the charge (pp. 24 and 25), it will be seen that it contains just what was here requested.

   He said to the jury, among other things, "that the party having embraced within his claim the use of fat liquor in its pure and simple state, the question of heat, or of the use of the compound, was not very important to the interests of the parties, because, if the party claimed in his patent what was not new, or a substantial or material part of which was not new, the patent was void."

   The judge was not bound to repeat himself at the whim of a party.

   See authorities under point Five.

FOURTEENTH.

Finally, complaint is made that the court refused to charge "that the patent could not be sustained in the matter of the mere degree of heat, if the principle of applying heat to any extent was an old process." (Record, p. 28).

1. The record shows that the judge declined to charge as requested, except as he had already charged.

So far as this point involves the question of novelty, the charge had fully covered the ground, and in accordance with the request. (Record, pp. 24 and 25).

See also, extract from the charge under point Thirteen.

2. If it was intended by the request to elicit a ruling that a patent could not be sustained for a *mere degree* of heat, then it was, in that particular, purely abstract and speculative.

The specification does not fix any exact degree of heat, and the plaintiff below did not ask to have his patent sustained on that ground.

If the patentee had restricted his claim to an exact degree of heat, either in the preparation or application of the liquor, his patent would have been utterly valueless to him; for any party might have taken all the benefits of the invention by varying the temperature half a degree, without infringing the patent.

FIFTEENTH.

Construction of the Patent.

In the litigations under this patent, there has occurred a disagreement among the judges, in the Circuit Court, in regard to the construction of the specification in an important particular; and as there are other suits pending which involve the same question, it is desirable to have a final and authorative construction.

One construction, and that claimed by the patentee, is, in brief, that the patent covers two things: 1. A novel treatment of bark-tanned sheep or lamb skins,

by heated fat liquor, substantially as described in the specification; and, 2, the treatment of such skins with a heated compound, composed and applied substantially, as specified.

The other construction is the one given by the court below in the case at bar, and now adopted by the plaintiff in error. It is, in brief, that the specification embraces two claims: 1. The use of fat liquor, pure and simple, as it comes from the mills substantially as described in the specification; and, 2, the compound substantially as described, and that the heating of the liquor is an essential portion of the process under this claim.

The point of difference is, the *heating* of the fat liquor under the first claim, when it is used without the other ingredients; the patentee claiming that by a fair construction of the patent, it covers only heated fat liquor, while on the other side it is claimed that it covers the use of *cold* fat liquor as it comes from the mills.

The importance of this question lies in the fact that, by the latter construction, the patentee's first claim is enlarged beyond his intention, and the field of alleged prior use extended in proportion, thus endangering the validity of the patent.

The patent should receive the construction claimed by the patentee, for the following, among other reasons:

1. If it will bear either construction, it should receive the one most favorable to the patentee,—that which will be most likely to protect the invention.

   See authorities under point Ten, *supra*.

(*a*). The *intention* of the patentee is to be sought in giving construction to the language; and for this purpose, particular phrases must not be singled out, but the whole specification and claim must be taken together.

Whitney v. Emmett, Bald., 303, 315.
Ames v. Howard, 1 Sum., 482, 485.
Page v. Ferry, 1 Fisher, 298, 302.

(*b*). If it appear with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, it will be adjudged sufficient, and the rights of the patentee will be protected, however imperfectly or inartificially he may have expressed himself.

Authorities last cited.

2. In construing the claim, it is proper to look at the original patent.

Johnson v. Root, 1 Fisher, 351, 355.

In the original specification (see Record, p. 20), it is perfectly clear that the patentee intended the use of fat liquor in a *warm* state, only.

He says, "I warm the same by heating to or near the boiling point."

Warm fat liquor is the first and principal thing. He then mentions the addition of certain other ingredients to such "*heated fat liquor*," constituting the compound.

He supposed that he had patented the use of *warm fat liquor alone*, "the principal feature of his invention" as expressed in the re-issued patent, as well as the compound, but found that his claim only covered the compound.

Now, it is said that the re-issue embraces not only fat liquor alone, but fat liquor in a *cold* state, or what, in other words, was not embraced at all in his original patent.

(*a*). A re-issue must be for the *same invention.*

5 Stat. at Large, p. 122.

It is not to be presumed that the patentee intended to embrace in the re-issue what he had not invented or described in the original, and thus destroy his patent.

(*b*). The power and duty of granting a new patent for the original invention, upon a surrender of the old, is confided to the Commissioner of Patents; and his decision is not re-examinable by the courts, unless it is apparent upon the face of the patent that he has exceeded his authority, or unless there is a clear repugnancy between the old and the new patent, or unless the new has been obtained by fraud or collusion between the commissioner and the patentee.

The presumption upon all these points is in favor of the regularity and validity of the re-issue.

Potter v. Holland, 4 Blatchf., 238, 242.
Battin v. Taggert, 17 How., 74, 84.
O'Reily v. Morse, 15 How., 62, 112.
Hussey v. McCormick, 1 Fisher, 509, 515.

(*c*). By the well settled rules of construction already referred to in this discussion, the court will not give a construction that will create a repugnancy between the old and the new, and thus invalidate the patent, if the language of the specification and claim, taken together, and in connection with such extraneous facts as may aid in disclosing the intention of the patentee, will admit of another construction.

3. The language and structure of the specification require the construction claimed by the patentee.

(Record p. 8.)

The specification commences by stating in what the invention consists, in these words: "a novel treatment of what is known 'as bark tanned lamb or sheep skin,' which, in the bark-tanned state, is too hard and stiff for glove making, but when subjected to this treatment is rendered suitable for gloves."

Stated generally, then, the invention consists of a *novel treatment* of a certain kind of skin, a *process* or *processes;* and the manner and character of this treatment or process is to be thereinafter described.

The specification then proceeds to describe *the novel treatment* or *process* constituting the invention; and commences by saying that the "*principal feature*" of the invention consists of the employment of fat liquor.

It does not say, it should be observed, that the *whole* invention, or the whole of *any* or *either claim*, consists in the mere employment of fat liquor: but that this is a *principal feature*. The expression "*principal feature*," implies that there are other features.

It is pertinent to observe, also, in view of certain criticisms upon the specification to be noticed hereafter, that fat liquor as the *principal feature*, applies to the compound or *second claim*, as well and as fully as to the *first claim*.

As, therefore, the fat liquor is to be heated when used in the compound, no inference against its heating when used alone, can be legitimately drawn from the statement that the employment of fat liquor constitutes the *principal feature* of the invention.

If it intends *heated* fat liquor in one case, as is conceded, it must in the other also.

The specification then goes on to describe further the "novel treatment," and the other *features* of the invention, and says: "In treating leather," that is, the leather before mentioned, 'bark tanned lamb or sheep skin,' "with fat liquor, it is desirable to heat the latter to or near the boiling point, and it is preferred to use the same," *i. e.*, fat liquor *heated*, "in connection with other ingredients."

This plainly says, "in treating the leather with *fat liquor*," not with the compound, "it is desirable to heat the latter," i. e. the *fat liquor alone*, "to or near the boiling point."

It will be observed that the heating of the liquor is mentioned before a word is said about other ingredients; and there can be no doubt that the patentee intended the heating of the fat liquor as a part of his process.

In prescribing the compound, the specification says. "There may be added to each ten gallons (10 gals.) of such *heated fat liquor*," thus showing clearly that the patentee intended *heated* fat liquor, both when used alone, and as the base of the compound.

Afterwards, in speaking of the treatment of the skin, the specification says: "the same should be well dipped in or saturated with the *fat liquor*, or *compound* of which the fat liquor is the base."

While this includes the treatment of the skins with the fat liquor alone, and also with the compound, of which *heated* fat liquor is the base, it does not repeat the word "heated;" hence the omission of the word "heated" when applied to the immersion of skins in the *fat liquor alone*, does not, as has been alleged in criticism of the specification, afford a presumption that the patentee did not intend *heated* fat liquor under the first claim.

On the contrary, it affords a strong presumption of the reverse.

The construction asked by the patentee, is confirmed by reference to the formal claim at the close of the specification. Read in connection with, and construed in the light of the whole specification, it is two-fold: 1. "The employment of fat liquor in the treatment of leather, *substantially* as specified," that is to say, *heated* and applied to the skin substantially as specified. 2. The process, substantially as herein described, of treating bark-tanned lamb or sheep skin, by means of a compound composed and applied essentially as specified," that is to say, a *heated* compound composed and applied essentially and substantially as specified.

(*a*). It has been said, in support of the adverse construction, that the words "*desirable*" and "*preferred*" in the specification are used to express the same idea, and each used in contrast with *essential* or *necessary*.

This, it is respectfully submitted, is a mistake

The word "*desirable*" applies to the use of the fat liquor, whether alone or in the compound, and refers to the *degree* of heat, and not to the *fact of heating*.

The patentee does not mean to say that it is not *essential* or *necessary* to *heat* the fat liquor, but, that it is not essential to heat it *up to or near the boiling point*.

The language is not the most apt that might have been employed to express the intention, but reasonably plain, nevertheless. The draughtsman evidently assumed the *fact* of

heating, and sought to describe the temperature without limiting it to an exact degree.

This view is strengthened by reference to the original specification, (Record, p. 20), where the expression is "*warm the same by heating to or near the boiling point.*"

Here there is no question about the *fact* of heating being essential; and the formula, substantially, was transferred to the re-issued specification, and there applied to both claims.

If, from the language employed, there is no question about the necessity of heating under the old patent, and none when applied to the compound under the new, why should the same language receive a different construction when applied to fat liquor alone?

The word "*preferred*" applies to the compound, and means, simply, that the inventor prefers it to the use of the heated fat liquor alone, and hence he describes and patents it.

This word may be said to be used, in contrast with *essential* or *necessary*, in reference to producing the desired result; that is to say, such result may be produced by the heated fat liquor alone, and that is claimed and patented; but the inventor prefers the compound, and that is claimed and patented also.

SIXTEENTH.

If any error occurred in the construction of the patent in the court below, it was in favor of the plaintiff in error; he did not except to it, or ask a different construction, and cannot now be heard to complain.

On the construction given, there was a question of fact for the jury, which was submitted to them under proper instructions.

The judgment of the Circuit Court should be affirmed, with damages and costs to the defendant in error.

HORACE E. SMITH,
Of Counsel for Defendant in Error.

OPINION OF JUDGE WOODRUFF ON MOTION FOR NEW TRIAL.

CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF NEW YORK.

NATHAN C. RUSSELL
against
ALBERT KLEIN.

Motion by the defendants, for a new trial.

Mr. H. E. Smith for the plaintiff.

Mr. Matthew Hale for the defendant.

Woodruff, J.

In connection with the like motion in Russell vs Place argued at the same term, I have considered the various points made by the counsel for the defendants on the argument, and the exceptions taken on the trial, and am of opinion that there is no sufficient reason for disturbing the verdict. The conflict of evidence upon the questions of fact is great, and made it a very proper case for submission to the jury. The impression on my own mind, after a careful examination of the testimony is, that the verdict is right, and the plaintiff is in fact the inventor of a new and useful process secured to him by his patent, and that the defendant is a willful and deliberate infringer of his rights.

On the construction of the patent, and specifications and claims, the learned District Judge before whom, sitting in the Circuit, this case was tried, expressed an opinion differing from the construction given on the trial of Russell v. Place. There the defendants in-

sisted that the use of heat in the treatment of skins was an essential part of the patented process and I yielded to the claim so urged, and so instructed the jury. No such claim was made by the defendant in this case, and the judge expressed the contrary opinion; but this instruction was not excepted to by the defendant, and he is not, as a matter of right, entitled to question the correctness of the charge to the jury on that point. In that particular, the question on a motion for a new trial is not simply whether the instruction was correct. If it appeared to me to be erroneous and yet it was clear that it worked no injustice to the defendant, it would be no reason for granting a new trial. I do not even now understand the defendant's counsel to insist that it was erroneous. The defense is put upon other grounds of attack upon the patent and the claim of the plaintiff to have first invented the process.

The reason why the instruction, whether it was correct or not, wrought no injustice, is that the plaintiff's charge of infringement was wholly confined to the use of his process including heat, and there was no pretense of claim, against the defendant, of violating the plaintiff's rights by using fat liquor without heating it: Nor was there any proof of any use by the defendant since the plaintiff's process was patented otherwise than by heating the ingredients in the compound employed. Nor was the verdict for any other use or for any treatment of leather except by first heating the fat liquor and other ingredients used.

So far, therefore, as this trial and verdict are concerned, and upon the actual state of the plaintiff's allegations and proof on the trial, the question whether the use of heat is an essential part of the process or not is purely speculative and immaterial. The exception to the reception of evidence became also wholly immaterial since the evidence itself led to nothing.

The purpose was to show that the defendant's witnesses were in a combination to defeat the plaintiff's patent and to share the expense.

This, if proved, might affect their credibility, and the moment it appeared that the witness did not know who signed it, it became irrelevant and harmless. Doubtless the judge would have struck it out, or so instructed the jury, if desired.

But as to its admissibility, and therefore the propriety of allowing the plaintiff to prove such a combination among the defendant's witnesses, if he could, I have no doubt; and it was one of those collateral matters arising incidentally in the progress of a trial, forming no part of the merits of a controversy, but going to the credit of a witness called by the defendant, which may be proved by the witnesses themselves, although no notice to produce has been given to any one. To whom shall such notice be given? There is no presumption that the defendant has possession of such a paper; nor can the plaintiff know in advance who will be called by the defendant to testify.

On the principal questions, as already observed, I think the instructions of the court to the jury were correct, or at any rate, as favorable to the defendant as he had a right to require; and that the special instructions sought, were charged as fully as the law would allow.

The motion for a new trial must be denied, with costs.

Ordered accordingly.

U. S. Supreme Court.

ALBERT KLEIN, *Plaintiff in Error,*

AGAINST

NATHAN C. RUSSELL.

SUPPLEMENT TO BRIEF OF DEFT. IN ERROR.

FIRST.

The point in the Brief of the plaintiff in error, (p. 8,) that the re-issue is not for the same invention, is not well taken.

1. It was not made in the court below, and is not, therefore, now available to the plaintiff in error.

The general request to direct a verdict for defendant, did not call the attention of the court to this point.

Although numerous specific requests were made, embracing every possible question that the ingenuity of counsel could suggest, this did not occur to counsel, and it is not to be supposed that it occurred to the court.

The Supreme Court will not express an opinion upon a

a matter of defense, not brought to the consideration of the court below.

Bell *vs.* Bruen., 1 How., 169.

2. The original specification did embrace warm fat liquor as the principal thing in his invention; but it was defective in omitting to make the proper claim.

See fifteenth point in Brief, sub. 2, and authorities there cited.

3. Variations from the description in the original specification, do not necessarily imply that the re-issue is for a new or different invention, for the right to surrender and obtain a new patent is given for the purpose of enabling the patentee to give a more perfect description, and cover what he has invented, and the second necessarily varies from the first.

And, the defect entitling the patentee to a re-issue may be in the specification or claim, or both.

O'Reilly *vs.* Morse, 15 How., 112.
Battin *vs.* Taggert, 17 How., 84.
Carver *vs.* Braintree Manuf. Co., 2 Story, 439, 440.

4. Whether a re-issued patent is substantially for a different invention from the first patent, is a question of fact for the jury.

Stimpson *vs.* Westchester R. R., 4 How., 404.
Carver *vs.* Braintree Manufacturing Co., 2 Story, 441, 442.
Allen *vs.* Blunt, 2 Wood. & Min., 139.

(*a.*) A re-issued patent is presumed to be for the same invention as that included in the original patent. But such inference or presumption in respect to identity is open to be contradicted by proper evidence, which should be submitted to the jury.

Allen *vs.* Blunt, cited *supra*.
O'Reilly *vs.* Morse, cited *supra*.

SECOND.

There is an ingenious sophism in the statement of plaintiff in error, that every witness examined agreed that the applica-

tion of fat liquor to leather for the purpose of making it soft and pliable, to use in glove making, had been known and in general use for many years.

(See his Brief, p. 13.)

In most instances of the prior use of fat liquor referred to by the witnesses, it was employed in connection with, and used in aid of, the oil tanning process from the raw. That is, it aided in *tanning* the leather; and, in so far as converting raw pelts into leather by the oil tanning process makes the skin soft and pliable, it may be said fat liquor had been used for that purpose.

But this is not the use, purpose, process or effect patented. It is the use of fat liquor, as described, upon skins *already tanned;* it is not for the purpose, nor does it have the effect of *tanning* them; but it gives them new properties, and changes their character, thus rendering them suitable for gloves.

(See reference to the testimony under third point of Brief.)

THIRD.

There is nothing in the point made by plaintiff in error that the specification conceals the fact that fat liquor had been long used for softening leather.

(See his Brief, p. 11. sub. 3.)

1. The fact alleged to have been concealed is wholly immaterial.

   The invention is not, simply, for the use of fat liquor in softening leather, but for the use of fat liquor in the *condition*, and in the *manner* described and claimed.

2. This defence was not set up in the plea or notice of special matter, and is not, therefore, available to the plaintiff in error.

   Act of 1836, Chap. 357, § 15.
   (5 Stat. at Large, 117.)

FOURTH.

The position of plaintiff in error, that the patentee is estopped from claiming the use of warm fat liquor, because it was claimed in his original patent, is extraordinary.

(See his Brief, p. 14, Sub. 1.)

If this position is tenable, it follows that whatever a patentee has properly described and claimed in his original patent, is lost to him on a surrender and re-issue.

This construction would defeat the very purpose of the patent law, allowing a surrender and re-issue in case of a defective specification and claim.

(See authorities, *supra*, under first point, sub. 3.)

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